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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91161817
Party	Plaintiff Nextel Communications, Inc. Nextel Communications, Inc. ,
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

NEXTEL COMMUNICATIONS, INC.,		
Opposer,		
v.	Opp. No.:	91/161,817
	App. No.:	78/235,618
	Pot. Mark:	SENSORY MARK (911 Hz tone)
MOTOROLA, INC.,		
Applicant.		

OPPOSER'S MAIN BRIEF

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I. INTRODUCTION

Motorola is seeking the registration of an electronically generated sound. It cannot be registered, because it is an operational alert tone that is an intrinsic functional feature of the two-way radios for which registration is sought, and it does not function as a mark.

The sound is always used and is always understood as a functional signal. Motorola has never used it as a mark or attempted to communicate to consumers, through "listen-for" advertising or otherwise, that it should serve as a source identifier. The sound, like the dozen or more other alert tones Motorola's radios emit, is merely a variant on the commonplace electronic alert tones used by all manufacturers of trunked two-way radios. As such, it does not function as a trademark.

Even if it were not non-registrable for these reasons, the sound is not inherently distinctive, because it is commonplace in the industry as well as in other contexts. Nor has the sound acquired distinctiveness. The survey Motorola commissioned for this proceeding was fatally flawed in its design and implementation, and provides no information whatsoever on the question of whether consumers associate the sound with a single source, Motorola.

Registration should be denied.

II. DESCRIPTION OF THE RECORD

The record in this proceeding comprises the evidence listed below, except where objections to such evidence have been noted by Opposer on the record. For ease of reference in this brief, each item of evidence will be referred to by the letter designation appearing in the listing below. For example, Exhibit 3 to the testimonial deposition of David Klein, which is marked as Exhibit I, is referred to as Ex. I, Klein Trial Tr., at Ex. 3.

EXHIBIT A: file history for Application Serial No. 78/575,442 (pursuant to 37 C.F.R. §§ 2.122(b), (e), and filed with Notice of Reliance dated August 25, 2006).

EXHIBIT B: Applicant's Responses to Opposer's First Set of Interrogatories, Nos. 5, 6, 7, 8, 10, 16, 17, 20, and 22 (filed with Notice of Reliance dated August 25, 2006).

EXHIBIT C: Applicant's Responses to Opposer's First Set of Requests for Admissions, Nos. 5, 6 (filed with Notice of Reliance dated August 25, 2006).

EXHIBIT D: Applicant's Responses to Opposer's Second Set of Requests for Admissions, Nos. 38-39, and 117 (filed with Notice of Reliance dated August 25, 2006).

EXHIBIT E: Applicant's Responses to Opposer's Second Set of Interrogatories, No. 3 (filed with Notice of Reliance dated August 25, 2006).

EXHIBIT F: Opposer's Responses to Applicant's Interrogatories, Nos. 6, 7, 8, and 10 (filed with Notice of Reliance dated November 26, 2006).

EXHIBIT G: Applicant's produced documents Bates Nos. MOT_004796-005451 and MOT_004773-004774 (filed with Notice of Reliance dated August 25, 2006).

EXHIBIT H: printed publication/periodical *American City & County*, April 2003, Pages 23 and back cover (Pursuant to 37 C.F.R. § 2.122(e), and filed with Notice of Reliance dated August 25, 2006).

EXHIBIT I: the following pages and exhibits from the Rule 30(b)(6) discovery deposition of Motorola, Inc. witness DAVID ERIC KLEIN:

Pages: 13-14; 17-18; 25; 27-28; 32-33; 42-50; 55-70; 89-95; 101-111; 117-120; 123.
Exhibits: Ex. 2; Ex. 3; Ex. 4; Ex. 5; Ex. 10; Ex. 11 (filed with Notice of Reliance dated August 25, 2006).

EXHIBIT J: the following pages and lines from the Rule 30(b)(6) discovery deposition of Nextel Communications, Inc. witness ALLISON O'REILLY:

Pages/Lines: 25:10-14; 27:1 through 28: 23; 31:22-25; 33:1–11, 20-25; 34:14 through 35:15; 36:10 through 37:16; 43:8-12; 43:24 through 44:1; 45:15-20; 46:24 through 47:11; 55:10-12 (filed with Notice of Reliance dated November 26, 2006).

EXHIBIT K: the following pages and lines from the Rule 30(b)(6) discovery deposition of Nextel Communications, Inc. witness ALLISON O'REILLY:

Pages/Lines: 23:13-16; 25:15-19; 34:1-13; 35:16 through 36:9; 37:17 through 38:2; 41:25 through 42:1; 42:12 through 43:7; 43:13-23 (filed with Notice of Reliance dated January 16, 2007).

EXHIBIT L: trial testimony of Mr. Henrik Rasmussen, dated August 24, 2006, including Exhibit No. 1 (filed January 16, 2007).

EXHIBIT M: trial testimony of Mr. Thomas Hoyes, dated August 25, 2006 (filed January 16, 2007).

EXHIBIT N: trial testimony of Michael Rappeport, dated October 19, 2006, including Exhibit Nos. 1 - 4 (filed December 19, 2006).

EXHIBIT O: trial testimony of Mr. David Eric Klein, dated November 14, 2006, including Exhibit Nos. 1 - 12 (filed December 14, 2006).

EXHIBIT P: trial testimony of Dr. Jacob Jacoby, dated January 12, 2007, including Exhibit Nos. 1 - 10 (filed March 15, 2007).

III. RECITATION OF FACTS

The sound sought to be registered here is an electronic alert tone, which is generated by two-way radios to signal the operational status of a particular function of the radios. As Motorola quite candidly explained in response to an Office Action, it is "a sound that emanates from a two-way radio to alert user or receiver of an incoming call or the availability to speak." Ex. A, App. File, at 10/17/03 Response to Office Action.

Motorola's April 9, 2003, application for registration of the sound described it as "a tone at 911 Hz played at a cadence of 25 milliseconds (ms) on, 25 ms off, 25 ms on, 25 ms off, 50 ms on" (the "911 Hz Tone"). *Id.* at Application. The Application was filed under Section 1(a) of the Lanham Act and claimed May 6, 1991, as the date of first use and of first use in commerce. *Id.*

In the trial phase of this case, Nextel presented testimony of Henrik Rasmussen, an experienced radio system manager, and Nextel employee Thomas Hoyes, and Motorola presented the testimony of Motorola employee David Klein and Dr. Michael Rappeport, who presented a survey. Nextel then presented rebuttal testimony of Dr. Jacob Jacoby, a survey research expert.

A. Motorola Has Not Used the 911 Hz Tone as a Mark.

Motorola alleged that it used the sound as a mark by selling two-way radios that contained an electronic chip that emits the sound when a particular radio function is activated. *See* Ex. B, at Int. Nos. 5-6. But such alert signals are critical operational features of the types of radio systems represented by the products at issue here. *See* Ex. O, Klein Trial Tr., at 75:22 through 77:23; Ex. L, Rasmussen Trial Tr., at 25:8-22. Motorola did not engage in any "look for" or "listen for" advertising or otherwise feature the 911 Hz Tone as a trademark rather than as an alert tone. *See* Ex. O, Klein Trial Tr., at 95:14 through 96:14, 102:4 through 104:4, 105:24 through 107:1. Customers and potential customers only encountered the sound in one of four circumstances, and in each case, the sound was expressly presented for its significance as an alert tone with a particular meaning. *See* Ex. O, Klein Trial Tr., at 73:10-24, 96:20 through 97:10, 101:10-16. In no case was the sound presented as a source identifier. *Id.* Motorola relied instead on its registered word mark and logo for recognition of its product. *See* Ex. O, Klein Trial Tr., at 76:23 through 77:4, 103:16 through 104:4; Ex. I, Klein Dep., at 45:21 through 46:3. Finally, Motorola's survey provided no evidence of any use of the tone as a mark.

1. The 911 Hz Tone is an Operational Alert Signal Signifying the Availability of an Open Channel.

In response to Nextel's Interrogatory No. 6, which requested Motorola to describe in detail the manner in which it purports to use or to have used the 911 Hz Tone in commerce, Motorola stated the following:

> Applicant has used the 911 Hz Tone in commerce by, among other things, offering to sell and selling two-way radios and cellular telephones that contain the chip referred to above (*see* Response to No. 5) and from which the [911 Hz] Tone can be heard.

Ex. B, at Int. No. 6. Motorola's response to Interrogatory No. 5, which had asked for a detailed description of the way in which the 911 Hz Tone was affixed to any goods, was that the 911 Hz

Tone was affixed "through an electronic chip resident in the device and from which the sound originates and emanates." Ex. B, at Int. No. 5.

The 911 Hz Tone was created when the radios were first developed in 1983 or 1984, and the parameters of its cadence and frequency were predetermined by the interval at which the radios' communications protocol permitted pulses and the frequency on which their single frequency generator operated. *See* Ex. O, Klein Dep., at 36:8-11; Ex. I, Klein Trial Tr., at 58:9 through 60:25. The 911 Hz Tone, like the numerous other signal tones emitted by the Motorola radios, was formed simply by using integral multiples of the given cadence and frequency. *See* Ex. I, Klein Dep. at 58:9 through 60:25; Ex. O, Klein Trial Tr., at 33:12-19, 38:6-14.

Radios manufactured by other companies also emit various sound signals, *see* Ex. I, Klein Dep., at 92:14-19, 94:16-22; Ex. L, Rasmussen Trial Tr., at 24:8 through 25:22, but for the first twenty years it manufactured its two-way radios, Motorola had never undertaken any investigation to determine whether other radios use exactly the same 911 Hz Tone. *See* Ex. I, Klein Dep., at 94:7-15. Motorola undertook such an investigation midway through this opposition proceeding, but never completed it, and is still unaware of whether the same tone is used as an alert signal by other two-way radios. *See* Ex. O, Klein Trial Tr., at 82:10-17, 82:24 through 83:8.

The 911 Hz Tone, like other two-way radio signal tones, serves a specific, primary function, namely to signify the activation of one of the operations of the radios in which the tone-generating chip is embedded. Mr. Rasmussen, the Radio System Manager for the City of Durham, North Carolina, provided information about the features of two-way radio systems from multiple manufacturers. Mr. Rasmussen has extensive personal experience with such systems. In his current position, which he has held since 1997, his duties include management of the city's

Motorola-supplied shared two-way radio system, which has approximately 3,000 users, and the related user units, portable radios, mobile radios, and base stations for the system, as well as the radio dispatch system in the 911 center for Durham County. He is also responsible for determining system equipment needs and specifying equipment for purchase, as well as for training and for responding to complaints from users about the operation of the system. He personally uses a Motorola two-way radio on the city system, and interacts on a daily basis with other Durham employees who are users of the system. *See* Ex. L, Rasmussen Trial Tr., at 1-7, 16.

During the late 1970s, Mr. Rasmussen established a two-way radio company that was eventually broken up into several parts, including Radio Communications Company, which sold and installed a trunked two-way radio system manufactured by GE, and Direct Call, Inc., which provided service through trunked radio systems that sold and used equipment manufactured by Kenwood, as well as Motorola, E.F. Johnson, and Vertex. Mr. Rasmussen was involved in sales and user training for both companies and was responsible for responding to complaints from users about the operation of the system. He remained a full-time employee of Direct Call, Inc. until accepting his current position with the City of Durham. Based on his extensive personal experience, Mr. Rasmussen is familiar with the operation of trunked two-way radios manufactured by Motorola, Kenwood, E.F. Johnson, Vertex, and GE (now M/A-COM). *See* Ex. L, Rasmussen Trial Tr., at 10-19.

Mr. Rasmussen explained the significance of the tone in all "trunked" two-way radio systems, including Motorola's. Because trunked systems dynamically allocate frequencies among many users, it is necessary to have the system first look for and confirm the availability of a channel before the user can communicate. *See* Ex. L, Rasmussen Trial Tr., at 20:22 through

21:9. If it finds an available channel, "[t]he system then lets the end-user know that that process has happened by causing his radio to emit an electronic sound that gives him a feedback that he has successfully gained a channel and the ability to have a conversation." *Id.* at 21:9-13. If it does not, the user's radio emits a different tone signal, to which Mr. Rasmussen refers as the "bonk" tone, to alert the user that no channel is available. *Id.* at 21:14-19, 24:2-3.

Motorola's Rule 30(b)(6) witness Mr. Klein confirmed that the 911 Hz Tone signifies either that "the channel[']s available for communication or that the microphone is active and transmitting." Ex. I, Klein Dep., at 44:22-23. Although he attempted in his trial testimony to assert that the sound also served a second purpose, Mr. Klein nonetheless consistently admitted that the alert function was the "first" manner in which it is used (*see* Ex. O, Klein Trial Tr., at 15:22 through 16:4) or "base element" of what Motorola intends it to communicate (*id.* at 28:24 through 29:4) or "immediate function" of the tone:

> Q. So let's just imagine a user of a Motorola 911 Hz radio in the field with a firefighter presses the button and hears the 911 Hz tone. That is what happens, correct?
> A. Correct.
>
> Q. And it's important for that firefighter to know that the meaning of that is that the channel is open so he can talk, correct?
> A. **The immediate function of the tone is that the channel is available.** In addition, because of the consistency of the tones, he also knows that he's using a Motorola product which also means that if he hears something else because he knows it's a Motorola product, he will actually have an expectation of what those other sounds, tones or user interactions mean.

Ex. O, Klein Trial Tr., at 74:22 through 75:12 (emphasis added).

That the function of the 911 Hz Tone is to signify the operational status of a two-way radio is supported by the testimony of Mr. Rasmussen:

> Q. Do all two-way trunked radio systems work this way or just Motorola?
> A. From the user's point of view all the trunked systems do work in that fashion.

Ex. L, Rasmussen Trial Tr., at 21:20 through 22:3. The 911 Hz Tone is one of a dozen or more different audible tones emanating from two-way radios, each signifying the activation of a different operation or feature of the radio. *See* Ex. I, Klein Dep., at 50:8-20. Mr. Klein described these sounds as follows:

> Q. And for these 911 Hz radios, each emits nine to 12 different tones, is that correct?
> A. I believe that is actually what I stipulated prior, but they actually generate more tones than that.
>
> Q. And each of the tones has a different significance in terms of the operation and function that it signifies, is that right?
> A. For the most part each tone has a sole function to the radio and it's clearly delineated in the user manual and in the training guides.

Ex. O, Klein Trial Tr., at 74:1-11.

Mr. Rasmussen testified that other trunked two-way radios, manufactured by Motorola's competitors such as M/A-COM and Kenwood, also emit a number of different tones to denote the operation of different features.

> Q. . . . Are you familiar with the signaling tones emitted by the trunked two-way radio products manufactured by all of the manufacturers with which you've had direct experience?
> A. I am familiar with the fact that they all make the tones. I couldn't necessarily identify one like some people identify bird calls of a particular bird. But partly that is because the tone's just a very short little beep or chirp or whatever. When you press it and so it's not all that unique or distinctive you get a beep and you know it worked.
>
> Q. Do all of the trunked two-way radios which you've had direct experience from the different manufacturers emit a ready-to-talk tone?
> A. Yes.
>
> Q. Do all of those radios emit a bonk tone?
> A. Yes.

Ex. L, Rasmussen Trial Tr., at 24:8 through 25:4; 42:14-19.

Similarly, Motorola's Mr. Klein witness, when asked whether competitors' products also emitted a "Talk-Permit" tone, stated that "[i]t would be my assumption that those products would

require some type of indication to notify the user that . . . either the channel is available or the mike is active." Ex. I, Klein Dep., at 92:14-17.

The 911 Hz Tone and the other tones emitted by Motorola's two-way radios have been kept consistent over successive generations of two-way radio products because the consistency makes it possible for users (including public safety, police and fire officials) to recognize the activation of the same operational feature without being retrained. *See* Ex. I, Klein Dep., at 42:21 through 43:14; *see also* Ex. O, Klein Trial Tr., at 38:19 through 39:14, 77:5-18. As Mr. Klein explained, using the same tone to signify the same feature in different products "allows [customers] to understand what's happening without them interacting." Ex. I, Klein Dep., at 43:9-11; *see also* Ex. O, Klein Trial Tr., at 38:19 through 39:14. This permits what Motorola refers to internally as "Hands on, eyes off" operation of the products by users. Ex. I, Klein Dep., at 42:21-23, 77:5-18; *see also* Ex. O, Klein Trial Tr., at 38:19 through 39:14.

Particularly in the public safety sector, it is important for users to be able to distinguish the operational meaning of the radio's tones. Ex. O, Klein Trial Tr., at 75:22 through 77:23.

2. There is No Evidence that Motorola Ever Used the 911 Hz Tone as a Source-Indicating Mark.

Motorola has never run radio or television advertising in which the 911 Hz Tone is featured, or even audible, because it does not run any broadcast media ads for the two-way radios. *See* Ex. O, Klein Trial Tr., at 95:14-19. Motorola does run print ads for the two-way radios and distribute other promotional material including specification sheets, but there is no evidence that Motorola has ever made any reference at all to the 911 Hz Tone itself in any such print materials. *See* Ex. O, Klein Trial Tr., at 95:20 through 96:19.

Mr. Klein appeared as Motorola's 30(b)(6) witness and as its only testimonial witness with knowledge of the use of the 911 Hz Tone by the company. In response to questions from counsel for Nextel, Mr. Klein was unable to provide any evidence of the following:

> (1) that Motorola ever made any statement "that the talk-permit tone is primarily the way to distinguish the source of the two-way radios," Ex. O, Klein Trial Tr., at 102:14-20;
>
> (2) that Motorola has "made any attempt to direct the attention of users or customers to the 911 Hz tone as a trademark for two-way radios," *id.* at 102:21 through 103:15;
>
> (3) that in the context of training reference systems or demonstrations, trade shows and user manuals, Motorola "ever made a statement or indication that potential customers should listen for the 911 Hz tone as a trademark of Motorola," *id.* at 105:24 through 106:6; or
>
> (4) that on Motorola's website promoting the two-way radio products "anything appearing in the text on those web pages inform[s] purchasers that the 911 Hz tone per se is intended to function as a trademark." *Id.* at 106:7 through 107:1.

In his 30(b)(6) deposition, Mr. Klein asserted that when the tone is heard by a user, the user would know the product is a Motorola product expressly because the product also is marked with "the Motorola label, the trademarks, the bat wing emblem, things like that." Ex. I, Klein Dep., at 45:21 through 46:3. In his testimonial deposition, Mr. Klein explained that "Motorola goes through a large effort to ensure that the Motorola branding is always visible from almost every single angle that you can look at our products." Ex. O, Klein Trial Tr., at 18:23 through 19:2.

Mr. Klein ultimately asserted that when users have heard the Talk-Permit tone, there was somehow an automatic linkage to "our branding image of two-way radio being robust, reliable, dependable, the whole positioning in the market." *Id.* at 101:6-8. But Motorola never provided any evidence of whether or how that alleged additional meaning of the Talk-Permit tone was

ever actually presented, pursued, or accomplished. The closest Motorola appears to have come to doing so was in the following testimony of Mr. Klein:

> I have done the trade shows where I've placed the radio in the users' hands and said press it, hear the tone, that means you're on the system. That means you're – this is working. No matter what happens when you hear that tone, your Motorola radio is working and you're able to get through.
>
> It's highlighting the importance that they are purchasing a reliable communication tool that voice will always get through. For public safety, government, federal and all these different customers, that is the key importance for them so when you're talking with them you want to highlight that, you know, there is your distinguishable feedback of, look, what you hold in your hands always works.

Id. at 78:20 through 79:10. But even in this testimony, Mr. Klein first emphasizes the operational significance of the tone – when you hear the tone you're able to get through. His additional assertion – that the message that the radio is working will be understood by consumers as an indication that Motorola radios "always" work – is unsubstantiated. There is no evidence in the record of Motorola's having made such a statement, or of the tone being understood in such a way by consumers.

3. The 911 Hz Tone is Encountered by Customers or Potential Customers in Only Four Circumstances, None of Which Feature the Tone as a Source-Indicating Mark.

During his testimonial deposition, Mr. Klein confirmed that there were only four circumstances in which customers encounter the 911 Hz Tone:

(i) through Motorola-provided training;
(ii) in user manuals and documentation explaining the product;
(iii) through contacts with direct sales representatives and demonstrations using reference systems; and
(iv) at trade shows and in user groups.

See Ex. O, Klein Trial Tr., at 97:3-10. In each of those circumstances, the tone is presented as a signal that the Talk-Permit function of the radio has been activated.

a. Training Sessions and Materials Present the 911 Hz Tone in its Operational Function, Not as a Mark.

The 911 Hz Tone is made audible, along with other alert tones, during live user training and in certain interactive audiovisual training materials. *See* Ex. O, Klein Trial Tr., at 81:1-4. Motorola's training efforts specifically seek to train users to recognize the 911 Hz Tone as associated with a particular operation of the two-way radios.

> Q. Motorola trains users of 911 Hz radios to recognize the talk-permit tone, isn't that right?
> A. Motorola has training materials and manuals that specify the operation of the two-way radios and includes the definition of that tone and in computer-interactive trainings the user can hear the tone, yes.
>
> Q. And in particular you train users to recognize that the 911 Hz tone signifies that a channel is available to talk, isn't that correct?
> A. So the training to identify that a channel is open is referenced to that tone so that is – they are – it is a tone that is associated with that type of operation, yes.

Ex. O, Klein Trial Tr., at 72:14 through 73:3; *see also* 75:22 through 77:23.

b. Motorola User Manuals and Documentation Refer in Writing to the 911 Hz Tone in its Operational Function, Not as a Mark.

The 911 Hz Tone is not made audible in Motorola's user manuals and documentation, but is referred to in text. In all cases, those documents only refer to the operational significance of the 911 Hz Tone. *See* Ex. I, Klein Dep., at Ex. 3, XTS™ 300 Astro User Manual (at MOT_002215-2217), Ex. 4, MTX-800™ Privacy Plus® User Manual (at MOT_000269) and Ex. 5, STX® 800/821 SmartNet™ User Manual (at MOT_000321-322). In user manuals for various products, the 911 Hz Tone is described using different wording, sometimes as "medium-pitched" tones and sometimes as "high pitched" tones. *See id.*

The user manuals and written training materials provided to customers also describe the various other tones emitted by the two-way radios in addition to the Talk-Permit tone, all within

the context of explaining the functions and features of the products. *See* Ex. O, Klein Trial Tr., at 73:10-24.

c. At Trade Shows and in Sales Representative Demonstrations, the 911 Hz Tone is Made Audible Only in its Operational Function, Not as a Mark.

In his 30(b)(6) deposition, Mr. Klein acknowledged that when the 911 Hz Tone is made audible during trade shows or in demonstrations to potential customers by sales representatives or in operating "reference" systems, the tone specifically and exclusively denotes the activation of the Talk-Permit feature of the product. Mr. Klein explained that:

> The Talk-Permit tone from its inception has always indicated that when you hear this tone, you are being told that either there is a channel available for you now, or that the channel has been – you know, essentially you have the channel. The microphone is active. You can now speak.

Ex. I, Klein Dep., at 103:17-22. When asked "are there times . . . when the tone is heard and that's not the case?," Mr. Klein replied "No. The tone is specific to – the sound is specific to those events." *Id.* at 103:23 through 104:1. Motorola does not use the 911 Hz Tone in any other way during trade shows:

> Q. Now, at any of those trade shows, are you aware of any instance in which Motorola featured the 911 Hz Tone other than in connection with operation of the function that it signifies?
> A. I'm not aware of any other – any other presentation of that tone.

Id. at 123:16-21. He confirmed this same fact regarding situations in which the 911 Hz Tone might be heard in the context of a demonstration by a sales representative at a customer's facility:

> Q. And in that context as well, is it the case that when you hear the tone, it's because the channel open function is working?
> A. Again, the tone has <u>always</u> been in reference to either the call-back availability or of the microphone active and communications occurring.

Id. at 104:23 through 105:3 (emphasis added).

Mr. Klein reaffirmed this point in his testimonial deposition:

> Q So that -- let me rephrase the question slightly. In all three of those contexts; training, demonstrations, trade shows, when the 911 Hz tone was audible it was always to signify the operation of the talk-permit function?
> A The 911 Hz tone never indicated a different radio function.

Ex. O, Klein Trial Tr., 101:10-16.

Other operational tones generated by the two-way radios could also be heard at trade shows in the normal operation of the two-way radios:

> Q. In trade shows and sales rep demonstrations of the 911 tone Hz products other tones emitted by those products are made audible, is that correct?
> A. Yes, those tones are made audible if the event occurs.
>
> Q. And in training on 911 Hz tone products other tones are made audible, is that correct?
> A. During training the other tones are made audible.

Id. at 80:17 through 81:4.

4. Motorola Has Not Licensed the 911 Hz Tone or Sought to Enforce Exclusivity in the Tone.

In response to Nextel's Discovery Requests, Motorola produced no evidence that it has ever licensed the 911 Hz Tone to anyone. *See* Ex. B, at Int. Nos. 17, 20. At least one other company for a number of years sold Motorola-manufactured radios that emit the 911 Hz Tone but featured the brands of the seller and not Motorola. *See* Ex. I, Klein Dep., at 47:6 through 48:1; Ex. O, Klein Trial Tr., 41:11 through 42:3, 42:10 through 43:8. No license agreement was produced by Motorola covering the use of the 911 Hz Tone under the other company's brand. *See* Ex. O, Klein Dep. at 87:20 through 88:2.

The record indicates that Motorola has not followed through on its investigation to discover whether its competitors also use the 911 Hz Tone. *See id.* at 82:10-17, 82:24 through 83:8. No evidence has been presented of any effort by Motorola to enforce any rights in the 911 Hz Tone against any third party.

B. The 911 Hz Tone is Not Inherently Distinctive.

The primary function of the 911 Hz Tone is in connection with a non-trademark purpose, *i.e.*, to signal that the audio path is open. This same purpose is served by alert tones emitted by all trunked two-way radios. *See* Ex. L, Rasmussen Trial Tr., at 24:21 through 25:22. Users perceive the radio systems of all manufacturers as operating in the same manner. *See id.* at 21:20 through 22:3.

Motorola radios emit numerous operational tones other than the Talk-Permit tone, all related in terms of frequency, given the technical constraints that dictated the 911 Hz tone itself. *See* Ex. O, Klein Trial Tr., at 74:1-11 (numerous sounds); *see also* Ex. I, Klein Dep., at 63:20-25 (technical constraints). In fact, the 911 Hz Tone is one of more than a dozen operation-indicating sounds generated by Motorola radios. *See* Ex. I, Klein Dep., at 50:8-20, Ex. 3, XTS™ 3000 Astro User Manual (at MOT_002217), Ex 4, MTX-800™ Privacy Plus® User Manual (at MOT_000269) and Ex. 5, STX® 800/821 SmartNet™ User Manual (at MOT_000321); *see also* Ex. O, Klein Trial Tr., at 74:1-5.

Mr. Klein confirmed that the primary significance of these various tones emitted by Motorola two-way radios, such as those identified in user manuals, is operational:

> Q. And each of the tones has a different significance in terms of the operation and function that it signifies, is that right?
> A. For the most part each tone has a sole function to the radio and it's clearly delineated in the user manual and in the training guides.

Ex. O, Klein Trial Tr., at 74:6-11; *see also* Ex. I, Klein Dep., at 50:16-20, 62-63.

Mr. Rasmussen explained, based on his extensive experience in the two-way radio industry, why people and manufacturers have long relied on electronically generated tones to indicate operational status:

> Q. In your experience do two-way trunked radios emit signaling tones other than the two that you've just described?

> A. Oh, yeah. The various radios, the brands, and regardless of what type of system they're operating on, the radios are designed to provide the user with an audible alert that will vary depending on exactly what the radio's attempting to alert the user to. So there might be one recognizable tone that the user comes to learn means my battery's weak, I need to exchange batteries or go charge my battery. There might be a unique note that says you're out of range of the system, you can't talk from here. And then of course you get that ready-to-talk tone when you successfully activate the system, you get a failed to connect sort of a bonk if you don't get the system when you ask for. There are various tones that the user learns to interpret associated with various functions that the radio's attempting to alert him to.

Ex. L, Rasmussen Trial Tr., at 22:12 through 23:9.

Mr. Rasmussen also testified that manufacturers use the "ready to talk" and "bonk" tones to convey the operational status of a two-way radio because it increases user efficiency in operation of the phone:

> The manufacturers apparently recognize that the user needs that audible feedback in order to efficiently use the radio. If you get the beep you know you're not going to waste your time talking. The assumption when you hear the beep is I have connected. If you get the bonk you know to pause and try again. The radio sometimes may want to tell you other things like my battery's dying and even though it might have a visual indication of that if you're not looking at the radio when that takes place the radio needs some way of drawing your attention to the radio so you will look at it, so the radios use these audible beeps and noises to draw your attention to what the radio's trying to tell you.

Id. at 25:8-22.

The industry practice described by Mr. Rasmussen is evidenced by Motorola's "hands on/eyes off" policy – encouraging consumers to rely on the 911 Hz Tone as a signal regarding the operational status of the radio while using it in the field. Ex. I, Klein Dep., at 42:21-25; Ex. O, Klein Trial Tr., at 38:19 through 39:8.

The alert tones emitted by the two-way radios of various manufacturers all have certain similarities, including the following:

> [T]hey're all electronic sounds, electronic -- they're generated by electronics not tuning forks or bells or anything like that. They're all electronic sounds generated by the chips, integrated circuits, in the radio. They're all very short in duration

> which is important, you don't want time wasted for the user by listening to music, you want a quick response. And then there's amongst the various sounds that the radio makes there's enough uniqueness in those various tones for the user to be able to interpret the fact that he got this tone versus this tone.

Ex. L, Rasmussen Trial Tr., at 29:10 through 30:3. Mr. Rasmussen explained that the various "ready to talk" and "bonk" tones from different manufacturers have such commonalities because users need to know what the phone is doing:

> There is similarity from brand to brand in the fact that you do have to provide the same basic functional requirements to the user regardless of what brand of equipment you put in his hand. So a fireman or policeman pressing the button regardless of what brand of radio he needs he still has the same need to know that that communications did initiate or fail to initiation, so regardless of what brand of equipment they're using they have to be provided that functionality.

Id. at 30:10-19.

Mr. Rasmussen also testified that users of two-way radios do not express concern with the specifics of the "ready to talk" tones from different manufacturers, other than as needed to understand the operation indicated:

> My experience has been that the users do not appear to concern themselves with the specifics of the sound but just the fact that they get the sound. If you press the button you get a beep of some kind, you recognize that you have made a successful connection or if you get a sound I would describe as a bonk they know that they've not made a successful connection. I have never had a user of a two-way radio make any particular -- any remark of any kind about the actual sound that's made.

Id. at 27:6-15.

Mr. Klein testified, similarly, that the "talk-prohibit" tone when a channel is not available on the Motorola radios is lower frequency than the Talk-Permit tone, and is designed to be distinguishable to the ear, because "[c]ertainly the tone needs to assist the user in the functionality of the radio." Ex. O, Klein Trial Tr., at 77:17-18. He went on to speculate that for users of non-Motorola radios, different tones emitted by those products "would not necessarily guide them to the use of the products." *Id.* at 77:18-23. But Mr. Rasmussen, based on his work

managing systems using a number of different manufacturers' two way radio products, had direct experience to the contrary:

> I have actually had users who have used different brands of radios all within the same company or group of radios[,] and going from one brand to another brand there's no problem on their part about recognizing the tones for the function that they're providing an indication of . . . My experience has been that those users can use a Kenwood radio this morning, use a Vertex radio this afternoon, for instance, and the tones seem to be intuitive to them.

Ex., L, Rasmussen Trial Tr., at 27:15 through 28:3.

Besides being similar to the alert tones emitted by other manufacturers' trunked two-way radios, the 911 Hz Tone resembles electronic sounds made by other common devices. The responses underlying the survey report of Dr. Rappeport, which was prepared for Motorola, reveal that numerous survey respondents who heard the 911 Hz Tone identified it as some other commonplace sound they encountered in everyday life. For example, fifty of the responses were as follows:

- heart monitor / hospital monitor / CPR monitor / heart murmur machine (MOT_004799); (MOT_004835); (MOT_004905); (MOT_004909); (MOT_005177); (MOT_005143);
- smoke detector / fire alarm low battery or trouble mode (MOT_004819); (MOT_004857); (MOT_005241); (MOT_005263);
- low battery alarm for cell phone / cordless phone / pager (MOT_004847); (MOT_005437); (MOT_005271); (MOT_005393);
- navy shipboard radar (MOT_005089); (MOT_005185); (MOT_005283); (MOT_005401);
- electronic game (Atari / battleship / gameboy) (MOT_004853); (MOT_004869); (MOT_004913);
- answering machine (MOT_004861); (MOT_004865); (MOT_005015); (MOT_005101); (MOT_005303);
- computer sound (MOT_04877); (MOT_004881); (MOT_005169); (MOT_005213); (MOT_005319);
- scanner (MOT_004823); (MOT_004873);

- fax machine (MOT_004901); (MOT_005237); (MOT_005307); (MOT_005433); (MOT_005311);
- various phone sounds (MOT_004897); (MOT_004921); (MOT_004925); (MOT_004991); (MOT_005007); (MOT_005205); (MOT_005209); (MOT_004917); (MOT_005445); and
- "a siren, possibly possibly a police siren" (MOT_005287); "some kind of electronic measuring device" (MOT_004839); "like the recording sound when conversation being taped ex PSEG" (MOT_004749)

Ex. P, Jacoby Trial Tr., at Ex. 7. All told, at least 30 percent of respondents identified some common device other than a two-way radio upon hearing the 911 Hz Tone.

C. The 911 Hz Tone Has Not Acquired Source Indicating Distinctiveness.

Motorola presented a report by Dr. Michael Rappeport regarding a survey he undertook to determine whether the 911 Hz Tone "has or has not acquired source indicating distinctiveness (secondary meaning)". Ex. N, Rappeport Trial Tr., at Ex. 2 (at MOT_004677). The survey provides no evidence that the 911 Hz Tone has acquired distinctiveness. As Nextel's expert witness has explained, the survey was fatally flawed in its design, execution, and interpretation. Most fundamentally, its central question fails to address the necessary issue. In any event, the results of the survey, even if valid and reliable, could not support a finding of acquired distinctiveness for the 911 Hz Tone.

1. Motorola's Survey Evidence Does Not Establish Acquired Distinctiveness.

a. The Design of the Critical Survey Question is Fundamentally and Irrevocably Flawed.

In August 2005, Motorola hired an expert witness, Dr. Michael Rappeport, to conduct a survey of the tone. *See* Ex. N, Rappeport Trial Tr., at Ex. 2 (at MOT_004677). The survey was completed on September 14, 2005. *See id.* (at MOT_004687).

Nextel retained Dr. Jacob Jacoby, an expert in the field of survey research, to evaluate the survey and present his opinion regarding the survey in rebuttal testimony. Dr. Jacoby holds a doctorate in psychology with minors in statistics and sociology, and is a professor at New York University, where he teaches courses in Consumer Behavior and Introductory Marketing and Advertising Management. *See* Ex. P, Jacoby Trial Tr., at 4-5, 7-8. He is the author of 25 articles regarding trademarks and consumer perception over the last 12 years, and has presented testimony in over 55 cases since 2000, including testimony as an expert witness regarding survey research. *See id.* at 10-11 and at Ex. 2 (at 6-8, 9-14). Dr. Jacoby has designed and implemented thousands of studies over his career, including trademark studies regarding secondary meaning. *See id.* at 9-10.

Dr. Rappeport's survey involved administration of live interviews with 180 employees or volunteers at police stations and fire departments, in which the interviewee was played several sounds, including the 911 Hz Tone, on a CD or cassette tape player, and then was asked a series of questions. *See* Ex. N, Rappeport Trial Tr., at Ex. 2 (at MOT_004681-83).

Immediately after the interviewee heard each sound played, he or she was asked the following questions (interviewer instructions are in brackets):

> 1. If you happen to know what this sound is, please tell me what it is and what, if anything, you know about it. Please be as specific as possible. If you don't happen to know what the sound is, it is okay to say so. [RECORD VERBATIM WHAT THE RESPONDENT SAYS ABOUT THE SOUND . . . HERE PROBE ONCE WITH] Is there anything else?
>
> 2. IF THE RESPONDENT IDENTIFIED THE SOUND, BUT DID NOT MENTION THE NAME OF A SPECIFIC COMPANY IN HIS OR HER ANSWER, [ASK:] You said that the sound comes from a [ANSWER FROM PREVIOUS QUESTION]. Are you thinking of one company who makes that [ANSWER] or more than one company who makes that [ANSWER]?

Id. (at MOT_004681, 004690-93).

As Dr. Jacoby testified, the questions as structured do not ask respondents whether they associate the 911 Hz Tone with a particular company source, but rather whether respondents associated particular products with such a company. *See* Ex. P, Jacoby Trial Tr., at 21:15 through 23:7. The second question asks not about the sound but about a device named in response to the first question:

> What this question does is totally shift the respondent's perspective and mind from the sound to the implement or device that makes the sound. And this shift is intentional. If you take a look a little further on in that document at Bates page No. 4697 toward the bottom of these interviewer instructions, Dr. Rappeport says quote, and again these are instructions to the interviewer, quote, "For instance, if the respondent says the sound is a boiling tea kettle," the follow up question should be within quotes, "You said that the sound comes from a boiling tea kettle. Are you thinking of one company who makes that tea kettle or more than one company who makes that tea kettle?" Notice the focus here is on the tea kettle, not on the sound. So the interviewers are given guidance and indeed instructions to focus not on the sound but the device that makes the sound.

Id. at 22:3-21.

Dr. Jacoby goes on to explain the critical problem raised by this redirection:

> [A]s I understand it, that is not what is at issue here. What is at issue is whether or not in the minds of the relevant public, the sound has come to associate -- to signify a single source, that is the sound has acquired secondary meaning, not whether or not the implement, the device, the product has acquired or the name on that product has acquired secondary meaning.

Id. at 22:21 through 23:7. As a result, the responses to the central question of the survey provide no information about whether the respondents actually associated the 911 Hz Tone with any company they named in response to that question. *Id.* at 25:5-17.

In Dr. Jacoby's opinion, the redirection of the question away from the sound and to the device was particularly likely to affect the responses if the device itself was prominently branded with the company's name. *Id.* at 25:18 through 26:20.

Dr. Jacoby testified that the fundamental design flaw in the survey could have been avoided, by following a standard approach for assessing secondary meaning that would have

asked direct and straightforward questions about the sound itself. *See id.* at 26:22 through 28:1. In Dr. Jacoby's expert opinion, the flawed design of the critical question in Dr. Rappeport's survey rendered it "[i]ncapable of providing any valid reliable information on the question whether or not the 911 Hz sound has acquired a distinctiveness of secondary meaning." *Id.* at 20:1-4. He concluded that the survey responses could in no way properly be read as evidence of acquired distinctiveness of the 911 Hz Tone. *See id.* at 28:2-12 ("the data are irrelevant").

b. The Survey is Flawed in Other Respects.

Dr. Jacoby identified a number of other flaws in the survey that, apart from the design flaw that rendered it entirely irrelevant, would independently render it unreliable and invalid. They included flaws in its design, implementation, and interpretation.

i. The Survey Universe Was Flawed.

Mr. Klein testified that the users of Motorola's two-way radios emitting the 911 Hz Tone include "United States Federal Law Enforcement, state and local law agencies, emergency, fire, EMS," and that "it also goes to the private sector, whether it's private security, construction, event management companies. Anybody who is requiring immediate and reliable communication methods, the two-way radio products are an appealing solution." Ex. O., Klein Trial Tr., at 20:19 through 21:5. Dr. Rappeport's survey, however, only included respondents from police and fire departments. *See* Ex. N, Rappeport Trial Tr., at 37:5-8.

Dr. Jacoby determined that this limitation impermissibly underrepresented the relevant universe. *See* Ex. P, Jacoby Trial Tr., at 41:3 through 42:6. Without any evidence from Dr. Rappeport as to the size or likely difference or similarity of the omitted groups, Dr. Jacoby concluded that the flawed universe definition renders the survey totally unreliable. *See id.* at 42:7-12.

ii. Implementation of the Survey was Flawed.

Dr. Jacoby explained that, given the structure of the questionnaire and the nature of the interviewer instructions, there is no way to know exactly what the interviewers asked the survey respondents in the critical second survey question, because Question 2 required interviewers to insert the response from Question 1 into Question 2, but they were not required to record what words they inserted. *Id.* at 43:16-20. The problem was exacerbated because the response to Question 1 could, and often did, consist of multiple answers. *See, e.g., id.* at 44:2 through 45:9 and at Ex. 7 (at MOT_005233).

Dr. Jacoby also concluded that a similar problem occurred where insertion of the response to Question 1 into Question 2 would be nonsensical if the response was inserted verbatim, as required by the survey instructions. *Id.* at 45:10 through 46:12 and at Ex. 7 (at MOT_005233). Dr. Jacoby pointed out that interviewers were encouraged by the instructions to use their discretion in truncating the response they chose to insert in the second question, *see id.* at 74:6-15 and at Ex. 3 (at MOT_004697), but specifically to eliminate a reference to an event that created the sound and focus on the device rather than the sound or the event that caused it. *See id.* at 74:15 through 75:1 and at Ex. 3 (at MOT_004697).

Dr. Rappeport also testified that, while two-way radios were not provided to interviewees, he did not know whether they may have had two-way radios with them during the interview, and in fact that he "wouldn't be surprised if someone did..." Ex. N, Rappeport Trial Tr., at 19:12-14. Dr. Jacoby testified that failing to control this factor creates a key problem because the presence of a radio would represent an extraneous factor that could affect the respondent's answers. *See* Ex. P, Jacoby Trial Tr., at 50:16 through 51:4.

iii. The Interpretation of the Survey Results Was Flawed.

Dr. Rappeport concluded that 52 percent of the respondents had provided responses supporting the secondary meaning of the 911 Hz Tone. In order to reach that high a total, he testified that he relied on what he called "rational reason" as justification for combining incorrect answers with Motorola responses. In particular, when asked why he counted the 29 percent of respondents who identified Nextel as the sources of the chirp and the 9 percent who identified Motorola and Nextel as the single source of the chirp in his 52 percent composite, not just the 14 percent who named Motorola, he stated that "our understanding of the rule is single source albeit negative, albeit unknown, albeit even wrong, as long as there's a rationale for that single source . . ." Ex. N, Rappeport Trial Tr., at 39:22 through 40:2. Dr. Rappeport explained that "our charge was to find out how many people thought it was a single rational source, not whether they thought it was Motorola." *Id.* at 40:9-12. Dr. Rappeport testified that a reasonable basis for counting Nextel responses existed because:

> We understand Nextel makes an akin product; that is, a telephone system with a walkie-talkie option where their name appears on the thing and uses a different -- that system uses a different frequency chirp, but it's also used as a chirp.

Id. at 40:18-22.

This interpretation of the survey responses has no support in accepted principles of survey methodology. As Dr. Jacoby testified, combining answers based on a "reasonable basis" rather than empirical data was improper because Dr. Rappeport is "assuming what he has to prove." Ex. P, Jacoby Trial Tr., at 30:3-4. Dr. Jacoby explained that there is no principle justifying the use of a "reasonable basis" in lieu of actual data to count "Nextel" responses in combination with "Motorola" responses, especially in light of the fact that Dr. Rappeport testified that his pilot test produced a number of "Nextel" responses:

> So I guess I'm saying two things, number one, he's assuming what he has to prove, and number two, it doesn't matter – all of trademark law is about this – it doesn't matter what the source of the trademarks is insofar as likely confusion or intentions not to confuse or deceive or in secondary meaning or any of that stuff. What matters is what's in the minds of the consumers. And Dr. Rappeport has not told me or anyone and has not gathered any data as he should have to tell me what is in the mind of the consumer who answers Nextel only. He hasn't told me whether they think it's the same as the Motorola. He hasn't answered whether consumers who answer Motorola and Nextel are essentially saying there are two sources, not a single source.

Ex. P, Jacoby Trial Tr., at 31:15 through 32:8.[1]

c. If Its Methodological Flaws Were Ignored, the Survey Results Would Support the Conclusion That the 911 Hz Tone Has Not Acquired Distinctiveness as a Mark for Motorola Products.

Dr. Rappeport reported that, after discarding 16 interviews collected by one interviewer that could not be validated, leaving 164 interviews, the following percentages of respondents identified the named companies in response to either Question 1 or Question 2:

Motorola Only	14 percent
Nextel Only	29 percent
Motorola and Nextel	9 percent

Ex. N, Rappeport Trial Tr., at Ex. 2 (MOT_004685). After further eliminating responses he considered to reflect "guessing," he reported that the following percentages had both identified the respective companies and identified a radio or walkie-talkie as the device with which the sound was associated:

Motorola Only	11 percent
Nextel Only	24 percent
Motorola and Nextel	7 percent

[1] Dr. Jacoby discussed testimony Exhibit 7, survey response 8-206 (Bates No. 005377), as an example showing why Dr. Rappeport's "rational reason" methodology is unacceptable. *See* Ex. P, Jacoby Trial Tr., at 37:17 through 38:13. The response to Question 1 was "It's the sound in the Nextel commercial." *Id.* at 38:6-7. Dr. Jacoby explained that "this to me reflects a consumer who got that sound associated only with Nextel and has no evidence whatever in the record that this consumer associates Nextel with Motorola." *Id.* at 38:10-13.

Id. at Ex. 2 (at MOT_004686).

If only the responses to the first question ("If you happen to know what this sound is, please tell me what it is and what, if anything, you know about it") are considered, of the 44 respondents who named a company unaided, none named Motorola alone.[2]

2. Motorola Has Adduced No Circumstantial Evidence of Acquired Distinctiveness.

Motorola does not run any audiovisual advertising for 911 Hz Tone Products in which the 911 Hz Tone is heard. Ex. I, Klein Dep., at 117:10-24; Ex. O, Klein Trial Tr., at 95:14-19. In addition, there is no evidence in the record of any print advertising that specifically identifies the 911 Hz Tone. Ex. I, Klein Dep., at 107:20 through 108:1; Ex. O, Klein Trial Tr., at 96:7-19. Motorola's witness also testified that, in the context of training, reference systems, demonstrations, trade shows, and user manuals, he is not aware that Motorola has ever made a statement or indication that potential customers should "listen for" the 911 Hz Tone as a trademark of Motorola. Ex. O, Klein Trial Tr., at 105:24 through 106:6.

At trade shows, when the 911 Hz Tone was made audible it "never indicated a different radio function" than to signify the operation of the Talk-Permit function. *Id.* at 101:15-16. Other alert tones generated by the two-way radios could also be heard at trade shows in the normal operation of the radios, signifying the activation of the applicable function. *Id.* at 80:17-24 ("[T]hose tones are made audible if the event occurs.").

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[2] Four respondents named both Nextel and Motorola, one named Direct Connect and Motorola, and another named Boost Mobile and Motorola. Direct Connect and Boost Mobile are registered trademarks under which Nextel provides goods and services.

Mr. Klein, although able to testify as to Motorola's annual budget for trade shows, was unable to state what part of those expenditures was exclusively for the presentation of the 911 Hz Tone. *See id.* at 94:2 through 95:13.

Mr. Klein testified that while Motorola's website has links to specification sheets and brochures for two-way radios, he was not aware, based on his general familiarity with the content of those web pages pursuant to his general job function, of anything appearing in the text on those web pages to inform purchasers that the 911 Hz Tone per se is intended to function as a trademark. *See id.* at 106:7 through 107:1.

D. Nextel Has Standing to Oppose Registration of the 911 Hz Mark.

Sprint/Nextel is one of the largest providers of cellular telephone services in the United States. *See* Amended Notice of Opposition, at ¶ 1; Amended Answer at ¶ 1. Nextel owns the Nextel Chirp and the Nextel Chirp Application. *See* Amended Notice of Opposition, at ¶ 11; Amended Answer, at ¶ 11 at Ex. A, Nextel Chirp Application File Wrapper.

The Motorola goods at issue in this matter are two-way radios, which Motorola sells to public safety agencies, such as police, fire and EMT agencies. *See* Ex. A, App. File (goods in application); *see also* Ex. O, Klein Trial Tr., at 20:19 through 21:5 (channels defined).

Mr. Tom Hoyes, Nextel's North Region Vice President Public Sector, testified that Sprint Nextel's walkie-talkie phones are marketed to and sold to the public safety sector. *See* Ex. M, Hoyes Trial Tr., at 5:17 through 6:1. Mr. Hoyes testified that Sprint/Nextel currently has customers in the public safety sector, including "New York Police Department, D.C. Metropolitan Police Department, D.C. fire, New York fire, Boston Police, FBI, Secret Service, so on, so on, a lot of customers," (*id.* at 6:19-22) and that Sprint/Nextel considers Motorola to be

a competitor in the public safety sector, because "[w]e're both trying to sell devices to the same customer base." *Id.* at 7:5-6.

IV. STATEMENT OF ISSUES

The issues for the Board's resolution in these proceedings are as follows:

- Whether Applicant has used the subject mark as a trademark.
- Whether, if Applicant could sustain its burden of showing that it has used the subject mark as a trademark, a showing of acquired distinctiveness is also required.
- Whether, if Applicant could sustain its burden of showing that it has used the subject mark as a trademark and a showing of acquired distinctiveness is also required, Applicant has made a sufficient showing of acquired distinctiveness.

V. ARGUMENT

A. The 911 Hz Tone Does Not Function as a Trademark.

The Lanham Act defines a trademark as

> any word, name, symbol, or device . . . (1) used by a person . . . to identify and distinguish his or her goods . . . from those manufactured or sold by others and to indicate the source of the goods

15 U.S.C. § 1127. Thus, even if a "word, name, symbol, device, or a combination of words" is actually used in connection with goods, "it is not registrable unless it is used as a mark." *In re Morganroth*, 208 U.S.P.Q. 284, 287 (TTAB 1980).

The 911 Hz Tone does not meet this threshold requirement. It is merely "[a] a sound that emanates from a two-way radio to alert user or receiver of an incoming call or the availability to speak,"[3] and nothing more. It is an intrinsic feature of the goods that operates as an alert signal.

Trunked two-way radios, including those manufactured by Motorola, all generate tones to indicate different operational functions of the radios in order to increase their operating efficiency for users. *See* Ex. L, Rassmussen Trial Tr., at 25:8-22; *see also* Ex. I, Klein Dep., at 50:8-20, 94:16-22. As a result, consumers have come to expect radios to make such sounds. *See* Ex. L, Rasmussen Trial Tr., at 27:3-15. Indeed, Motorola and others actively train their users to recognize the tones as operational signals. *See id.* at 14:8-19; *see also* Ex. O, Klein Trial Tr., at 72:14 through 73:3. Because of this industry practice, consumers would not view the 911 Hz Tone as a trademark, but rather merely as an inherent feature of the radio that indicates its operational status.

The Board's recent decision in *In re N.V. Organon*, 79 U.S.P.Q.2d 1639 (TTAB 2006), addressed a remarkably similar circumstance in concluding that a particular flavor should not be registered as a mark for the applicant's medications. The Board refused registration of the flavor orange, based upon its finding that the flavor failed to function as a mark in connection with pharmaceuticals. In reaching this conclusion, the Board looked to industry practice, and found that:

> [I]t is standard practice within the pharmaceutical industry to flavor medicines to make them more palatable. This was true long before the application in this case was filed. . . . Because of this common practice, consumers would not view the flavor of a pharmaceutical as a trademark; rather, they would consider it to be an inherent feature of the product that renders it more appealing. In this respect, flavor is analogous to product design and color.

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[3] Ex. A, App. File.

Organon at 1649.

The Applicant asserted that its orange flavor was "unique" and therefore distinctive, notwithstanding common industry use of flavors, including orange. The Board found Applicant's argument unpersuasive, stating

> Even if we were to treat applicant's application as being for its 'unique' orange flavor, we would find that applicant's flavor fails to function as a mark. Because flavor is generally seen as a characteristic of the goods, rather than as a trademark, a flavor, just as in the cases of color and scent, can never be inherently distinctive. As previously discussed, flavor, including an orange flavor, is so intrinsic a feature of pharmaceuticals, that consumers will not perceive a flavor, even a "unique" orange flavor, as a trademark unless they have been educated to perceive it as such.

Id. at 1650 (emphasis added).

Just as the use of flavors in pharmaceuticals is common industry practice, the use of electronic alert tones in two-way radios is common industry practice. Consumers, upon hearing the 911 Hz Tone during the operation of a two-way radio, will not perceive the sound as a trademark unless they have been "educated to perceive it as such" through advertising or through featured use of the tone that creates a separate commercial impression of the sound as a source identifier.

Motorola's alleged "use" of the 911 Hz Tone has been only to embed the electronic chip in two-way radios that will emit an alert tone when the Talk-Permit function is activated. Ex. B at Int. Nos. 5, 6. That does not constitute use of the tone as a trademark. And Motorola has engaged in no "look for" or "listen for" advertising of the tone, and has provided no evidence that any of its activities at trade shows, sales demonstrations, or in user training were directed toward consumer recognition of the tone as a trademark. *See* Ex. I, Klein Dep. at 107:20 through 108:1, 117:10-21; Ex. O, Klein Trial Tr., 95:14-19, 96:7-19, 105:24 through 106:4. Rather, all consumer encounters with the 911 Hz Tone involve educating consumers and users as to the

operational feature signified by the 911 Hz Tone. Ex. O, Klein Trial Tr., 73:10-24, 101:10-16. Under the *Organon* decision, the 911 Hz Tone has not been used as -- and therefore does not function as -- a mark.

Moreover, as is common in the industry, the Talk-Permit tone is just one of more than a dozen alert tones emitted by Motorola's two-way radios. Ex. L, Rasmussen, 25:8-20; Ex. O, Klein Trial Tr., 74:1-5 (many tones). There is no evidence in the record to support the elevation of that one tone, among all the tones users hear when they operate the radios, to the status of a source-identifying mark.

The Board's decisions have long enforced a distinction between using a word, symbol, or device in connection with a good or service and actually using it as a mark. For example, in *Morganroth*, the Board held that the subject phrase was unregistrable because it was not so prominent, among all the material included in the applicant's ads, that it was likely to create a separate commercial impression on the reader. 208 U.S.P.Q. at 288. The phrase thus failed to function, per se, as a mark. *See id.; see, e.g., MicroStrategy Inc. v. Motorola, Inc.,* 245 F.3d 335, 58 U.S.P.Q.2d 1278, 1282-83 (4th Cir. 2001).

For similar reasons, the Board refused registration of one of a series of unique rating symbols in *In re Moody's Investors Serv., Inc.*, 13 U.S.P.Q.2d 2043 (TTAB 1989). The applicant had sought registration of "Aaa" as a mark for ratings services. *Id.* at 2044. The applicant had provided ratings using "Aaa" and eight other symbols since 1909, and it was the only company to use those symbols. *Id.* at 2046. Its application was rejected by the Examining Attorney, however, because the specimens did "not show use of the designation 'Aaa' as a mark identifying applicant's service." *Id.* at 2048. The Board affirmed, holding that:

> [I]t appears to us that applicant's various rating symbols, including the designation "Aaa," are used in the specimens of record to identify and distinguish

> not applicant's rating services, but rather the ratings themselves, and that they would be so perceived by the public. That is, the significance of the symbols, as they are used in the specimens, is that of rating symbols (i.e., indications of applicant's opinion of the investment quality of debt instruments), not service marks. While it is not inconceivable that a particular designation could be used, and therefore function, both as a rating symbol and as a trademark or service mark, applicant's designation "Aaa" is not so used in the specimens of record.

Id. at 2048-49. As in *Morganroth*, the fact that a designation could be used as a mark was insufficient to support its registration where the applicant had not proved that it was used as a mark.

Even where the asserted mark is not an actual operational feature of the product, as is the case with the 911 Hz Tone, the mere fact that material accompanies the product may not be sufficient to constitute use as a mark. Unless the specimen or other evidence adduced in support of an application shows that the applicant has used a "'constant pattern' or design to highlight" the particular word, symbol, or device sought to be registered in contrast with other such designations that are also used in connection with the product, the particular designation cannot be found to have been used as a trademark. *See MicroStrategy,* at 342 (emphasis added).[4]

As the Board noted in *Morganroth*, the trademark use requirement

> clearly does not contemplate that the public will be required or expected to browse through a group of words, or scan an entire page in order to decide that a particular word, separated from its context, may or may not be intended, or may or may not serve to identify the product . . . [A trademark] must be used in such a manner that its nature and function are readily apparent and recognizable without extended analysis. . .

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[4] The Board refused registration, for example, for a background design, even though it always appeared in conjunction with a company's registered marks, where there was no evidence that the applicant had "called attention" to the design per se "or otherwise ha[d] promoted this background design in a way that would set the design apart" from the marks with which it appeared. *In re Benetton Group S.p.A.,* 48 U.S.P.Q.2d 1214, 1216-17 (TTAB 1998). And where an applicant promotes an aspect of its product "simply as one more feature of its [goods]" rather than as an indication of origin, registration is not permissible. *In re Upper Deck Co.,* 59 U.S.P.Q.2d 1688, 1692-93 (TTAB 2001); *see also In re Niagara Frontier Svcs., Inc.*, 221 U.S.P.Q. 284, 285-86 (TTAB 1983).

208 U.S.P.Q. at 288 *(quoting National Geographic Society,* 83 U.S.P.Q. 260, 260-61 (Comr. 1941)); *see also In re Whataburger Sys., Inc.*, 209 U.S.P.Q. 429, 430 (TTAB 1980) (designation may not be registered unless it is used "in such a manner that its function as an indication of origin may be readily perceived by persons encountering the goods or services in connection with which it is used").[5]

Here, there is no evidence whatsoever that Motorola has ever used the 911 Hz Tone separate and apart from its significance as an alert signal. Moreover, the 911 Hz Tone, as one of numerous signals that Motorola and other manufacturers use as a matter of standard industry practice, and that consumers expect and understand as an intrinsic feature of the product, has not been separately featured by Motorola in any way that might educate consumers to perceive it as a trademark. Standing alone, and without regard to any other evidence in the record, these facts establish that the 911 Hz Tone has not been used as a trademark, does not function as a trademark, and may not be registered.

B. The 911 Hz Tone is Not Inherently Distinctive.

Even if the 911 Hz Tone had been used as a mark, it could not be found to be inherently distinctive. The handful of decisions addressing sound marks establish special requirements with respect to the question of distinctiveness. As the Board has observed, "the criteria for the registration of sound marks must be somewhat different" from the criteria for other more conventional types of marks, given the fact that, unlike a visually perceptible trademark applied

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[5] Motorola's witness's assertion that the 911 Hz Tone functions as a mark because when the tone is heard the MOTOROLA mark itself is visible (*see* Ex. I, Klein Dep., at 45:21 through 46:3; *see also* Ex. O, Klein Trial Tr. at 18:23 through 19:8) cannot bootstrap the tone into trademark status, where it is not used in a way that creates a separate commercial impression. *See, e.g., Textron Inc., v. Cardinal Eng'g Corp.*, 164 U.S.P.Q. 397, 399 (TTAB 1969); *Procter & Gamble Co. v. Keystone Automotive Warehouse, Inc.*, 191 U.S.P.Q. 468, 474 (TTAB 1976). Motorola's application is not for MOTOROLA and the 911 Hz Tone; it is for the 911 Hz Tone alone, and therefore, it must stand or fall as a mark on its own.

to goods, an asserted sound mark "depends upon aural perception of the listener which may be as fleeting as the sound itself." *In re General Elec. Broad. Co.,* 199 U.S.P.Q. 560, 563 (TTAB 1978).

Thus, especially for alleged sound marks that "resemble or imitate 'commonplace' sounds or those to which listeners have been exposed under different circumstances," persuasive evidence must be presented to support the acquired distinctiveness of the sound. *Id.; see also, e.g., Ride the Ducks, LLC v. Duck Boat Tours, Inc.*, 75 U.S.P.Q.2d 1269, 1274-76 (E.D. Pa. 2005). And for sound marks as well as other kinds of marks, an allegedly distinctive product feature or configuration that merely follows industry practice and meets consumer expectations for such a product, however unique it may otherwise be, will not be found inherently distinctive. *See, e.g., Organon,* 79 U.S.P.Q.2d at 1650 (where use of flavor is common in pharmaceutical industry, "a flavor, just as in the cases of color and scent, can never be inherently distinctive"); *CITC Indus. Inc. v. Levi Strauss & Co.,* 216 U.S.P.Q. 512, 516 (TTAB 1982) (batwing mark that "is not noticeably dissimilar from the trade practice use of functional shapes and configurations is not inherently distinctive and will not be registered in the absence of a showing of acquired secondary meaning").[6]

Analogously, applicants asserting trademark rights in product configurations or other non-traditional marks that have denotative meaning have been required to demonstrate "that the primary significance of the term in the minds of the consuming public is not the product but the

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[6] In addition to flavor marks, several other categories of non-traditional marks are not capable of being inherently distinctive. For example, the Supreme Court has held that color marks are never inherently didstinctive. *See, e.g., Wal-Mart Stores, Inc. v. Samara Brothers, Inc.,* 529 U.S. 205, 54 U.S.P.Q.2d 1065, 1068 (2000) (citing *Qualitex Co. v. Jacobson Products Co., Inc.,* 514 U.S. 159, 34 U.S.P.Q.2d 1161, 1162-1163 (1995)). In addition, "design, like color, is not inherently distinctive." *Wal-Mart,* at 1068. Further, the TTAB has held that scents are registrable upon a showing of secondary meaning. *In re Clarke,* 17 U.S.P.Q.2d 1238, 1239-40 (TTAB 1990).

producer." *Kellogg Co. v. Nat'l Biscuit Co.*, 305 U.S. 111, 39 U.S.P.Q. 296 (1938) (emphasis added); *see also Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 214 U.S.P.Q. 1, 4 n.11, 7 (1982) (pharmaceutical capsule colors, even though arbitrarily selected, served functional purpose).

Here, as Motorola's witness testified, the "immediate function of the tone is that the channel is available." Ex. O, Klein Trial Tr., at 75:6-7. All manufacturers of trunked two-way radios, including Motorola, use electronic sounds in connection with various operational features of two-way radios, including a "ready to talk" tone. Ex. L, Rasmussen Trial Tr., at 24:8-20. As explained by Mr. Rasmussen, audible signals are incorporated into two-way radios to enable efficient use of the radios. *See* Ex. L, Rasmussen Trial Tr., at 24:21 through 25:22. Motorola's witness Mr. Klein, when asked whether two-way radios made by competing manufacturers also used Talk-Permit tones, agreed: "It would be my assumption that those products would require some type of indication to notify the user that ... either the channel is available or the mike is active." Ex. O, Klein Trial Tr., at 92:16-19.

Further, the Talk-Permit and "bonk" tones made by two-way radios from various manufacturers all have basic similarities, including that they are short, electronic, and different enough from each other to enable the user to distinguish between the particular operational features they are indicating. *See* Ex. L, Rasmussen Trial Tr., at 29:10 through 30:19. Mr. Rasmussen testified that, in his broad experience, users of two-way radios do not express concern with the specifics of the sound other than as needed to understand the operation being indicated. *See id.*, at 27:6-15. He explained that the industry practice of using an array of sounds is a response to the fact that users need to know what the radio is doing. Ex. L, Rasmussen Trial Tr., at 30:10-19.

Motorola's own actions, as well as industry practice and the consumer experience described by Mr. Rasmussen, all indicate that the primary significance – indeed, the only significance – of the 911 Hz Tone is to communicate the functional status of the radio to users. The evidence establishes that two-way radios and similar devices use sounds as an intrinsic part of their operation and use. Thus, even if there were evidence to suggest that the 911 Hz Tone were purportedly "unique" in the sense that it could be distinguished by some listeners from the signal tones used by other two-way radio manufacturers, it would still, like the "unique" orange flavor in *Organon*, not be inherently distinctive.

Beyond this non-distinctiveness compared with common two-way radio alert tones, there is evidence in the record showing that, under the test suggested in the *G.E.* sound mark decision, the 911 Hz Tone resembles or imitates "commonplace" sounds or sounds "to which listeners have been exposed in different circumstances." *G.E.*, 199 U.S.P.Q. at 563. The individual responses underlying Motorola's survey reveal that over 30 percent of the survey respondents, who were users or potential purchasers of Motorola's products, thought the tone sounded like it came from various other devices they encountered in everyday life, such as a heart monitor, an electronic game, a smoke detector, an answering machine, a computer, a cell phone, or a variety of others, such as a scanner or an electronic measuring device. *See* discussion, *supra*, at 18 through 19. These responses show that the nature of the 911 Hz Tone is such that for a substantial percentage of users or potential users of two-way radios, it resembles or imitates commonplace sounds to which they have been exposed in different circumstances. As such, the 911 Hz Tone cannot be found inherently distinctive.

C. The 911 Hz Tone has Not Acquired Distinctiveness.

Nextel has made a *prima facie* case that the 911 Hz Tone is not inherently distinctive. As a result, if the 911 Hz Tone had been used as a mark, Motorola would be required to prove by at least a preponderance of the evidence that the 911 Hz Tone has acquired distinctiveness. *See Yamaha Int'l Corp. v. Hoshino Gakki Co., Ltd.,* 840 F.2d 1572, 6 U.S.P.Q.2d 1001, 1008 (Fed. Cir. 1988).[7] Motorola has not met this burden, as it has introduced no valid evidence of consumer recognition of the 911 Hz Tone as a mark indicating Motorola as the source of two-way radio products.

Motorola's survey is fatally flawed and entitled to no weight, and the minimal circumstantial evidence in the record is unrelated to use of the 911 Hz Tone. In order to establish acquired distinctiveness, the survey evidence must prove that the 911 Hz Tone identifies a single source in the minds of consumers, in the sense that the public has come to expect that every two-way radio emitting the tone is from Motorola. *See American Flange & Mfg. Co. v. Rieke Corp.,* 80 U.S.P.Q.2d 1397, 1414 (TTAB 2006); *see also* Ex. P, Jacoby Trial Tr., at 23:1-7. Dr. Rappeport's study falls far short of meeting that threshold requirement.

1. Motorola's Survey is Entitled to no Weight.

Motorola's survey is riddled with flaws, and actually provides no information regarding whether the 911 Hz Tone has acquired distinctiveness. First and foremost, the survey was designed to ask the wrong question, and is thus simply incapable of obtaining any information about consumer recognition of the tone as a source identifier. In addition, the survey universe is

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[7] In *In re Elevator Safety Co.,* the Board stated that "evidence required to show acquired distinctiveness is directly proportional to the degree of non-distinctiveness of the mark at issue." 2007 WL 616024 at *11 (TTAB Feb. 21, 2007) (citing *Yamaha,* 6 U.S.P.Q.2d at 1008). (Note: *Elevator Safety* is attached as Appendix A).

under-inclusive, the survey was not implemented properly, and it lacked adequate controls. Even if these fundamental flaws could somehow be ignored, however, the survey data, if anything, provide evidence that the 911 Hz Tone has not acquired distinctiveness in the minds of consumers as a source-indicating mark for Motorola's two-way radios.

a. Because of its Flaws, the Survey Provides No Evidence At All on Acquired Distinctiveness of the 911 Hz Tone.

The primary flaw in Motorola's survey design renders it completely useless regarding whether the 911 Hz Tone has acquired source identifying distinctiveness. In order "[t]o establish secondary meaning, a manufacturer must show that, in the minds of the public, the primary significance of a product feature or term is to identify the source of the product rather than the product itself." *Two Pesos Inc. v. Taco Cabana Inc.*, 505 U.S. 763, 23 U.S.P.Q.2d 1081, 1082 n.4 (1992) (citing *Inwood Labs.*, 214 U.S.P.Q. at 4 n.11). But because of the flawed design of Motorola's survey, the most it could show is that respondents knew that Motorola makes two-way radios – it provides no evidence whatsoever that the primary significance of the 911 Hz Tone is to identify the source of the products. *See American Flange,* 80 U.S.P.Q.2d at 1415.

The survey asked two principal questions. The first was designed to seek information about whether the sound is recognized as indicating a particular event, not a product's source. *See* Ex. N, Rappeport Trial Tr., at 50:7 through 53:14. The second, and critical, question redirected the interviewee away from both the sound and the event, asking instead about a product. Respondents who initially responded, for example, that the sound came from a two-way radio were asked the critical follow-up question in this form:

> You said that sound comes from a two-way radio. Are you thinking of one company who **makes that two-way radio** or more than one company who makes that two-way radio?

See, e.g., Ex. N, Rappeport Trial Tr., at 54:3-12 and at Ex. 2 (at MOT_004687) (emphasis added).

In other words, such a respondent was not being asked whether he or she associated the 911 Hz Tone with a particular company source, but whether he or she associated the particular two-way radios with a particular company. The question inappropriately directs the respondent's attention away from the sound to the product. *See* Ex. P, Jacoby Trial Tr., at 21:15-23:7.

Indeed, the instructions to interviewers about how to fill in the blanks in the second question are illustrated with the example of a response of "boiling tea kettle" – identifying both an event and a product – to the first question. The instructions direct interviewers to use the following form for the critical question:

> "You said that sound comes from a boiling tea kettle. Are you thinking of one company who makes that tea kettle or more than one company who makes that tea kettle?"

Id. at Ex. 2 (at MOT_004679) (emphasis added). In doing so, the survey instructions make clear that the critical question seeks information about an association between a product, not a sound or an event, and a company source. *See* Ex. P, Jacoby Trial Tr., at 21:15 through 23:7.

In the case of the Motorola products, the association between product and source could only have resulted from the prominent placement of Motorola's registered trademarks and logos on the two-way radios themselves. *See* Ex. O, Klein Trial Tr., at 18:23 through 19:8; Ex. I, Klein Dep., at 45:21 through 46:3 and at Ex. 7 (at MOT_002212) (graphical representation of portable radio); *see also* Ex. P, Jacoby Trial Tr., at 25:18 through 26:20 (testifying that the presence of the Motorola mark on the products affects responses given the improperly constructed question). This fundamental defect in the construction of the critical survey question

renders the results unreliable and the survey useless.[8] *See* Ex. P, Jacoby Trial Tr., at 19:16 through 20:4, 28:2-12.

Because Motorola's survey asked the wrong question, it is fatally flawed, and its results cannot and do not provide any evidence in support of registration. *See, e.g., American Flange,* at 1314 (question "does not begin to address whether relevant consumers view the product design as a source indicator"); *In re E.I. Kane*, 221 U.S.P.Q. 1203, 1206 (TTAB 1984) (although accurate, "we think the survey asked the wrong question").

b. Other Flaws Render the Survey Invalid and Unreliable.

The survey's universe of potential respondents was also flawed, in that it included respondents only from police and fire stations. As conceded by Dr. Rappeport, the sample did not cover the entire universe of users and potential users of two-way radios. *See* Ex. N., Rappeport Trial Tr., at 12:11 through 13:10. Rather, as described by Dr. Jacoby, potentially significant groups such as construction, building maintenance, private security, and event management were omitted. *See* Ex. P, Jacoby Trial Tr., at 40:4 through 42:10

If the target population of a survey is underinclusive, the survey's results may not be valid at all if the excluded population is likely to have responded differently. But the record provides no evidence as to the magnitude of the potential effect of Dr. Rappeport's exclusion of these portions of the relevant universe, because he did not have or seek any information about potential differences prior to excluding them. *See* Ex. P, Jacoby Trial Tr., at 40:4 through 42:10.

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[8] A further fatal flaw in the survey's design and implementation is that interviewers did not record the words they actually inserted in asking the critical second question, so it is impossible to be certain exactly what question produced any of the recorded responses. *See* Ex. P, Jacoby Trial Tr., at 46:13 through 47:3. But the instructions, at least, directed interviewers to ask about a product, not a sound or even an event.

The survey also lacked adequate controls. Dr. Rappeport's survey consisted of police, fire department and EMS users and potential users of two-way radios, some interviewed at their work places. *See* Ex. N, Rappeport Trial Tr., at 12:19 through 13:1. Some portion of the users may have had two-way radios with them during the survey. In fact, Dr. Rappeport testified that "I don't know whether any of them had a radio they use all the time themselves. I wouldn't be surprised if someone did..." *Id.* at 19:10-15. The possibility that some interviewees may have had a Motorola-branded radio with them during the interviews greatly undermines the reliability of the survey results. *See* Ex. P, Jacoby Trial Tr., at 50:15 through 51:4; *see also Marcalus Mfg. Co. v. Watson*, 156 F.Supp. 161, 115 U.S.P.Q. 232, 234 (D.D.C. 1957) (survey given no weight where interviewees could potentially see subject mark during interview).

Dr. Jacoby also identified a number of other flaws in the implementation of the survey, including inadequate training of the interviewers, evidence that the interviewers did not follow directions, and inadequate shielding of the interview environment. *See* Ex. O, Jacoby Tr. at 42:13 through 48:6 and 71:10-18 (lack of training); 48:6-20 (failure to follow directions); 48:21 to 50:13 (inadequate shielding). In particular, with respect to training, Dr. Jacoby pointed to the fact that the interviewers did not actually go through any practice runs with the surveys (*see id.* at 43:2-20) and that judgment calls with respect to interpreting survey answers were improperly left in the interviewers' hands (*see id.* at 46:3-6). Evidence that the interviewers did not follow instructions included several instances in which the interviewer either asked the second question when it should not have been asked or failed to ask it when it should have been. *See id.* at 48:6-17. In addition to not controlling for the presence of two-way radios in the interview room, Dr. Jacoby noted an absence of any evidence that Dr. Rappeport took steps to ensure that future

interviewees were not exposed to sounds coming from the interview location. *See id.* at 48:21 through 50:13.

c. Even if the Survey's Flaws Could be Ignored, Its Results Would Not Support Acquired Distinctiveness of Motorola's Purported Sound Mark.

In the end, Dr. Rappeport's report concluded that 52 percent of respondents associate the 911 Hz Tone with "Motorola and/or Nextel." *See* Ex. N, Rappeport Trial Tr., at Ex. 2 (at MOT_004685). After eliminating responses that had identified products other than what Dr. Rappeport interpreted as relevant, he concluded that "approximately 42 percent of the relevant population recognize the 'chirp' sound as that made by a Motorola and/or Nextel radio and/or walkie-talkie." *Id.* at Ex. 2 (at MOT_004686). But in reaching these conclusions, Dr. Rappeport impermissibly combines responses, in an apparent attempt to create a number that might support a finding of acquired distinctiveness. In fact, only 11 percent of respondents identified Motorola alone in connection with a radio or a walkie-talkie. *Id.* (at Table III).

Dr. Rappeport relies on a purported "rational reason" justification for combining other answers with the Motorola responses. Ex. N, Rappeport Trial Tr., at 39:10 through 41:3. His explanation of his theory, which allowed him to combine responses that were "even wrong," was difficult to discern. *See id.* He described the ultimate objective as to find out how many people thought the sound indicated "a single rational source." *Id.* at 40:10-11.

Dr. Rappeport's method is unsupported by any accepted principles of survey methodology or case law. When asked about the propriety of such a methodology, survey research expert Dr. Jacoby testified that in following this approach, Dr. Rappeport is in effect "assuming what he has to prove." Ex. P, Jacoby Trial Tr., at 30:3-4; *see also Carroll Shelby Licensing, Inc. v. Superformance Int'l, Inc.,* 251 F.Supp.2d 983, 987 (D. Mass. 2002) (a survey expert's "conclusory grouping" of Cobra, Shelby Cobra, and Ford Shelby Cobra responses to

increase result for "Shelby" to over 50 percent effectively "assumes the answer to the very question at issue," rendering the survey's conclusions "completely unreliable and bear[ing] no weight on Shelby's secondary meaning argument"). Without probing the understanding of a respondent who answers "Nextel," Dr. Jacoby explained, "you have no justification saying Nextel means Motorola." Ex. P, Jacoby Trial Tr., at 30:13-14.

Dr. Rappeport's "rational reason" theory fails to satisfy the very purpose of an acquired distinctiveness survey – to determine what is in the minds of consumers. *See Two Pesos Inc. v. Taco Cabana Inc.*, 505 U.S. 763, 23 U.S.P.Q.2d 1081, 1082 n.4 (1992) (citing *Inwood Laboratories, Inc. v. Ives Laboratories, Inc.*, 456 U.S. 844, 851, n.11, 214 U.S.P.Q. 1 (1982)). As Dr. Jacoby explained:

> What matters is what's in the minds of the consumers. And Dr. Rappeport has not told me or anyone and has not gathered any data as he should have to tell me what is in the mind of the consumer who answers Nextel only. He hasn't told me whether they think it's the same as the Motorola. He hasn't answered whether consumers who answer Motorola and Nextel are essentially saying there are two sources, not a single source.

Id. at 31:21 through 32:8. The Board has held that where survey respondents identify a single source, but name a company other than the applicant, those responses must be subtracted from the total single-source percentage in order to properly evaluate the results. *See American Flange* at 1414; s*ee, e.g., I.P. Lund Trading ApS v. Kohler Co.,* 118 F.Supp.2d 92, 56 U.S.P.Q.2d 1776, 1789 (D. Mass. 2000) (refusing to credit Dr. Rappeport's survey result of 55 percent because it was reached by counting single-source responses naming the plaintiff's competitors rather than just those naming the plaintiff, and because Dr. Rappeport had failed to probe whether the primary significance of the product configuration in the minds of respondents was as a product feature or a source identifier); *Zippo Mfg. Co. v. Rogers Imports, Inc.,* 216 F. Supp. 670, 137 U.S.P.Q. 413, 428 (S.D.N.Y. 1963).

In addition, it was improper for Dr. Rappeport to count responses that named both Nextel and Motorola, because those responses do not identify a single source. *See American Flange* at 1415.

Tabulation of the survey data without reliance on Dr. Rappeport's "reasonable basis" theory provides results that do not rise to the level of acquired distinctiveness. Dr. Rappeport reported that 14 percent of respondents identified Motorola in response to Question 1 or Question 2, and that the percentage drops to 11 percent after elimination of the responses he considered to reflect "guessing." Ex. N, Rappeport Trial Tr., at Ex. 2 (at MOT_004685-86.) Results of 14 percent or 11 percent are insufficient to find acquired distinctiveness. *American Flange* at 1414 ("Here, 19 percent is far short of the level necessary to show applicant's mark has acquired distinctiveness, even if the result was otherwise reliable."). Indeed, such percentage levels "indicate the absence of acquired distinctiveness, if they indicate anything at all." *See id.* at 1415.

2. The Circumstantial Evidence Does Not Support a Finding of Acquired Distinctiveness.

In the absence of any credible direct evidence of secondary meaning of a mark, an applicant may attempt to meet its burden through circumstantial evidence. However, Motorola has conducted no audiovisual, print, or online advertisements for 911 Hz Tone products in which the 911 Hz Tone is heard or referred to. *See* Ex. O, Klein Trial Tr. at 95:14-19 (audiovisual advertising); 96:7 through 19 (print advertising); 105:24 through 106:6 (no "listen for" advertising); 106:7 through 107:1 (website). In fact, there is no evidence of any attempt by Motorola to direct attention of users to the 911 Hz Tone as a trademark. *See* Ex. O, Klein Trial Tr., at 103: 10 through 104:4; *see also Thomas & Betts Corp. v. Panduit Corp.*, 65 F.3d 654, 36 U.S.P.Q.2d 1065, 1071-72 (7th Cir. 1995) (advertising "look for the oval head" for cable ties

encourages consumers to identify the claimed trade dress with the particular producer); *Brooks Shoe Mfg. Co., Inc. v. Suave Shoe Corp.*, 716 F.2d 854, 221 U.S.P.Q. 536, 541 (11th Cir. 1983) (advertisements for shoe design must involve "image advertising" to establish acquired distinctiveness).

Motorola's user manuals, training efforts, sales efforts, and appearances at trade shows do not focus on any trademark significance of the 911 Hz Tone. Collectively, they do nothing more than demonstrate that the primary significance of the 911 Hz Tone is to indicate the "ready to talk" status of a two-way radio. *See* Ex. O, Klein Trial Tr., at 72:14 through 73:24 (user manuals and training efforts); 101:10-15 (training, demonstrations, trade shows). Thus, as the Board stated in *Ennco Display Sys., Inc.*, 56 U.S.P.Q.2d at 1286, "applicant has not presented any convincing evidence of advertising or promotional efforts that focus upon the trademark significance of the product configurations, rather than the utilitarian or desirable features of the products." *See also Redken Labs.*, 170 U.S.P.Q. 526, 528-29 (TTAB 1971) (longstanding use and extensive exposure did not demonstrate that "the commercial impression created by such use and what it would mean to purchasers" was source identifying).

Here, any evidence of length of use, sales figures, or expenditures on trade shows would be meaningless without evidence showing that those efforts were tied to use of the 911 Hz Tone as a trademark. *See, e.g., In re Packaging Specialists, Inc.*, 221 U.S.P.Q. 917, 920 (TTAB 1984). *Yamaha,* 6 U.S.P.Q.2d at 1004; *In re Bongrain Int'l (American) Corp.*, 894 F.2d 1316, 13 U.S.P.Q.2d 1727, 1729 (Fed. Cir. 1990); *Braun Inc. v. Dynamics Corp.*, 975 F.2d 815, 24 U.S.P.Q.2d 1121, 1133 (Fed. Cir. 1992).[9] But Motorola has provided no evidence that any such

[9] Total expenditures on trade shows without financial breakdowns for expenditures related to playing the 911 Hz Tone are not probative of acquired distinctiveness. *See Duraco Prods. Inc. v. Joy Plastic*

(continued...)

use occurred. See Ex. O, Klein Trial Tr. at 94:2-21.

D. Nextel Has Standing to Oppose.

Nextel has standing to oppose registration of the 911 Hz Tone. *See* 15 U.S.C. § 1061(a). The Motorola goods at issue in this matter are two-way radios, which Motorola sells to public safety agencies, such as police, fire and EMT agencies. *See* Ex. 1, App. File; *see also* Ex. O, Klein Trial Tr., at 20:19 through 21:5. Sprint Nextel's walkie-talkie phones are also marketed to and sold to the public safety sector. *See* Ex. M, Hoyes Trial Tr., at 5:17 through 6:1; *see also id.* at 5:15-21; *see also* Ex. K, O'Reilly Dep., at 47:12-17, 22-24; *see also* Ex. H.

Thus, Motorola is a direct competitor of Nextel in the sale of communication devices to the public safety sector. *See* Ex. M, Hoyes Trial Tr., at 6:2-9. Nextel has standing to oppose the improper registration of an operational alert tone used in two-way radios by Motorola. As the Board has held, where a purported design mark was found to be non-distinctive and not functioning as a mark, "a registration thereof with all the presumption afforded such a registration will be damaging to opposer since it would preclude it from using this or a similar design in connection with its [products], as it would have a right to do when and if it so chooses." *Anchor Hocking Glass Corp. v. Corning Glass Works*, 162 U.S.P.Q. 288, 291 (TTAB 1969); s*ee also American Flange*, 80 U.S.P.Q.2d at 1401 ("Standing is not an issue in this case. Opposer has alleged and shown that it is a direct competitor of applicant in the sale of closure systems, the goods which are also the subject matter of the marks applicant claims here.").

(continued)

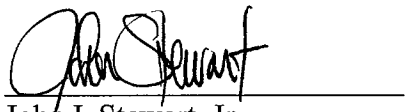
Enterprises Ltd., 40 F.3d 1431, 32 U.S.P.Q.2d 1724, 1741 (3d Cir. 1994) (advertising expenditures "measured primarily with regard to those advertisements which highlight the supposedly distinctive, identifying feature" of the product configuration); *see also In re E.I. Kane, Inc.*, 221 U.S.P.Q. 1203, 1206 (TTAB 1984).

VI. CONCLUSION

For all the foregoing reasons, Opposer, Nextel Communications, Inc., respectfully requests that the Board sustain the Opposition and deny registration to the mark in Application Serial No. 78/235,618.

Respectfully submitted,

March 15, 2007



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CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing OPPOSER'S MAIN BRIEF was served on counsel for the Applicant, this 15th day of March, 2007, by sending same via e-mail and First Class Mail, postage prepaid, to:

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P.O. Box 10395
Chicago, IL 60610

William J. Sauers

APPENDIX A

2007 WL 616024 (Trademark Tr. & App. Bd.)
(Cite as: 2007 WL 616024 (Trademark Tr. & App. Bd.))

***1** THIS OPINION IS NOT A PRECEDENT OF THE TTAB

Trademark Trial and Appeal Board

Patent and Trademark Office (P.T.O.)
IN RE ELEVATOR SAFETY COMPANY
SERIAL 76507505; 76507507; 76507675; 76507677; 76507734; 76507735; 76507737; 76507741 [FN1]
February 21, 2007
Oral hearing: June 20, 2006

James J. Merek of Merek, Blackmon & Voorhees, LLC for Elevator Safety Company

Linda A. Powell

Trademark Examining Attorney

Law Office 104

(Chris Doninger, Managing Attorney)

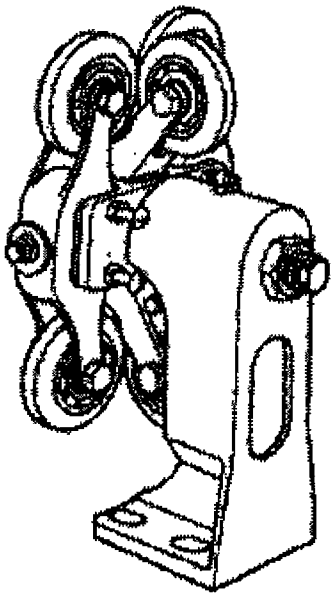
Before Rogers, Kuhlke and Walsh

Administrative Trademark Judges

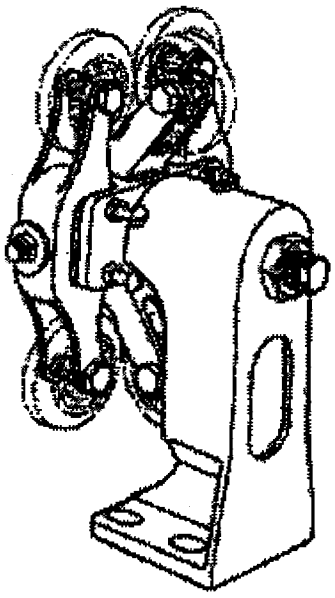
Opinion by Kuhlke

Administrative Trademark Judge:

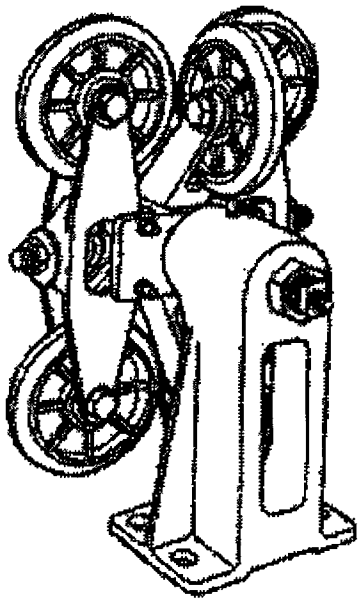
The Elevator Safety Company has filed applications to register as trademarks on the Principal Register the following:



for "elevator roller guides" in International Class 7, describing the mark as follows: "The mark consists of a three-dimensional configuration of an elevator roller guide. The roller guide includes three main components: the base mounting bracket, the central hub and the pivot arms. Each pivot arm holds two wheels, mounted at the extreme and opposite ends of the arm. The two 'side' pivot arms are identical, and consist of two parallel, generally diamond-shaped faces, connected in the middle by an elongated cylinder. Substantially oval holes at the center of each face of the pivot arm reveal the springs and some inner workings of the guide. The third pivot arm is disposed between the other two pivoting arms and is rotated approximately 90 degrees relative to the other arms. This 'face' pivot arm consists of two parallel faces, each shaped in an angular, three-section, wide-spread U configuration. These two planes are attached to each other in two places near the angles of the U shape. All three pivot arms are attached at their middles to a central hub, which consists of a cylindrical section attached to four flat rectangular surfaces. The base includes a substantially planar platform and a generally oval main support section, reinforced with an angled rib extending from the bottom of the main support section. The top of the oval main support receives the hub's cylinder. A large generally oval hole is formed in the lower portion of the main support"; [FN2]

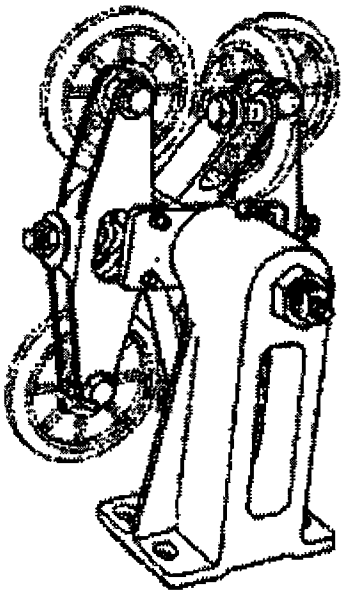


for "elevator roller guides" in International Class 7, the description of the mark is identical to the description in Serial No. 76507505 with the addition of the following: "The wheels depicted by dotted lines do not form any part of the mark in this application."; [FN3]

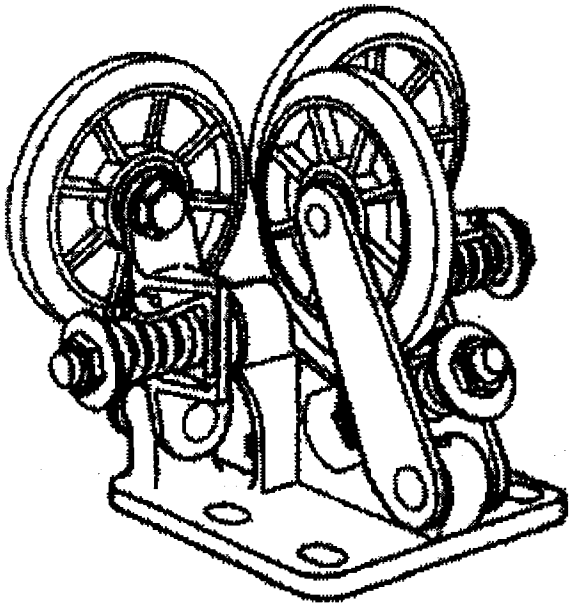


for "elevator roller guides" in International Class 7, describing the mark as follows: "The mark consists of a three-dimensional configuration of an elevator roller guide consisting of three main components: the base mounting bracket, the central hub and the pivot arms. Each pivot arm holds two wheels, mounted at the extreme and opposite ends of the arm. The two 'side' pivot arms are identical, and consist of two parallel, generally diamond-shaped faces, connected in the middle by an elongated cylinder. Oval holes at the center of each face of the pivot arm reveal the springs and some inner workings of the guide. The third pivot arm is disposed between the other two pivoting arms and is rotated approximately 90 degrees relative to the other arms. This 'face' pivot arm consists of two parallel faces, each shaped in an angular, three-section, wide-spread U

configuration. These two planes are attached to each other in two places near the angles of the U shape. All three pivot arms are attached at their middles to a central hub, which consists of a cylindrical section attached to four flat rectangular surfaces. The base includes a substantially planar platform and two main support sections, reinforced with angled ribs down the sides, that connect to a cylindrical top section of the base. This top cylinder receives the hub's cylinder. The two main supports are divided by a large, somewhat rounded, but generally rectangular hole"; [FN4]

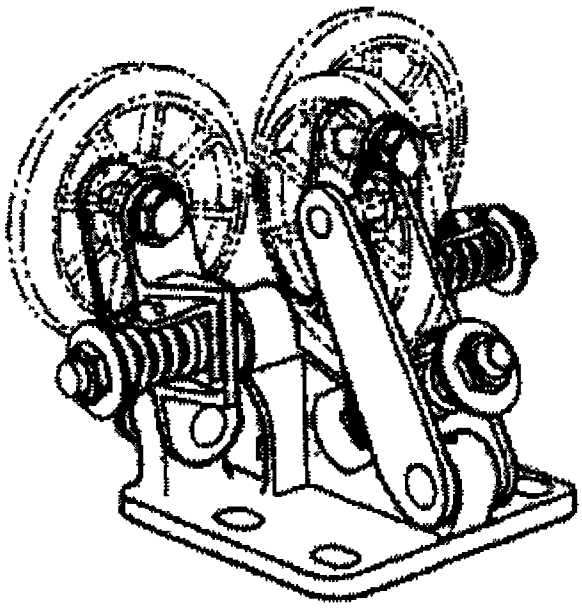


***2** for "elevator roller guides" in International Class 7, the description of the mark is substantially identical to the description in Serial No. 76507675 with the addition of the following: "The wheels depicted by dotted lines do not form any part of the mark in this application"; [FN5]

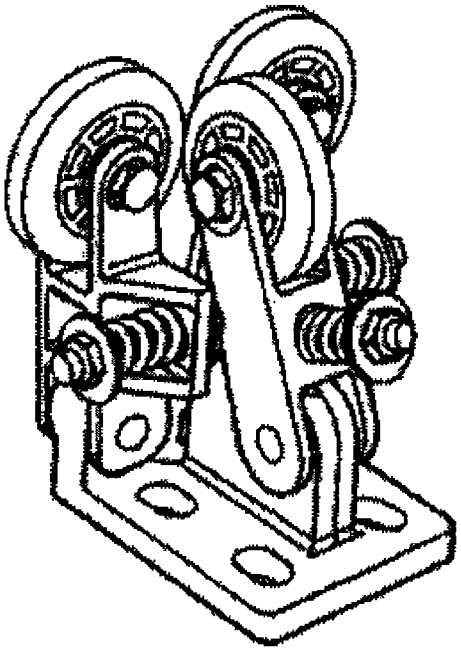


for "elevator roller guides" in International

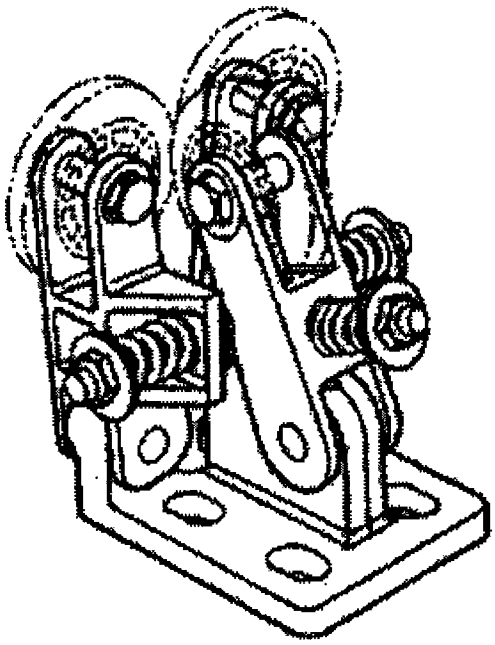
Class 7, describing the mark as follows: "The mark consists of a three-dimensional configuration of an elevator roller guide. The roller guide includes three main components: the base, three pivot arms and the spring and bolt assemblies. All three pivot arms consist of two parallel surfaces of generally elongated oval shapes. The two 'side' pivot arms have tabs that protrude from their sides. The two side pivot arms extend outwardly in a substantially V-shaped configuration from lugs cast into the base casting. The third 'face' pivot arm forms an acute angle with the base and extends upwardly from a third lug on the base and bisects the V-shaped configuration formed by the other two pivot arms. Two of the spring and bolt assemblies extend in opposite directions from each other and extend substantially parallel to the base. They are attached to a large ridge-like portion of the base. The third spring and bolt assembly forms an acute angle with the base and a 90 - degree angle with the face pivot arm. The base includes a substantially planar platform that has three lugs for attaching the pivot arms, as well as a large central ridge"; [FN6]



for "elevator roller guides" in International Class 7, the description of the mark is substantially identical to the description in Serial No. 76507735 with the addition of the following: "The wheels depicted by dotted lines do not form any part of the mark in this application"; [FN7]



for "elevator roller guides" in International Class 7, describing the mark as follows: "The mark consists of the three-dimensional configuration of an elevator roller guide. The roller guide includes three main components: the base, three pivot arms and the spring and bolt assemblies. All three pivot arms consist of two parallel surfaces of generally elongated oval shapes. The two 'side' pivot arms have tabs that protrude from their sides. The two side pivot arms extend outwardly in a substantially V-shaped configuration from lugs cast into the base casting. The third 'face' pivot arm forms an acute angle with the base and extends upwardly from a third lug on the base and bisects the V-shaped configuration formed by the other two pivot arms. Two of the spring and bolt assemblies extend in opposite directions from each other and extend substantially parallel to the base. They are attached to a large ridge-like portion of the base. The third spring and bolt assembly forms an acute angle with the base and a 90-degree angle with the face pivot arm. The base includes a substantially planar form that has three lugs for attaching the pivot arms, as well as a large central ridge."; [FN8] and



***3** for "elevator roller guides" in International Class 7, the description of the mark is substantially identical to the description in Serial No. 76507677 with the addition of the following: "The wheels depicted by dotted lines do not form any part of the mark in this application"; [FN9]

The proposed marks in the applications comprise four of applicant's elevator roller guides, referred to in applicant's literature as Models A, B, C and D. Models A (76507675 and 76507734) and C (76507505 and 76507507) have six wheels, but the central hubs and bases have a slightly different shape and the wheels in Model A are larger. Models B (76507735 and 76507737) and D (76507677 and 76507741) have three wheels, but the bases are slightly different in shape and the wheels in Model B are larger. Applicant seeks to register each of these models with and without the wheels for a total of eight applications.

The examining attorney refused registration under Section 2(e)(5) of the Trademark Act, 15 U.S.C. § 1052(e)(5), on the ground that applicant's alleged marks are functional, and under Sections 1, 2 and 45 of the Trademark Act, 15 U.S.C. § § 1051, 1052, 1127, on the ground that applicant's alleged marks are non-distinctive configurations that fail to function as trademarks. In maintaining the refusal under Sections 1, 2 and 45, the examining attorney also found that applicant did not make a sufficient evidentiary showing of acquired distinctiveness under Section 2(f), 15 U.S.C. § 1052(f).

When the refusals were made final, applicant appealed. Briefs have been filed and an oral hearing was held upon applicant's request. We affirm the refusals to register in each application.

EVIDENCE OF RECORD

In support of the refusals, the examining attorney submitted: (1) printouts from applicant's website; and (2) printouts from third-party websites. In response to the refusals, applicant submitted: (1) several third-party utility patents, including three utility patents owned by applicant's predecessor; (2) the declarations of Gordon Ferguson, General Manager of Eltec Systems, LLC and Wayne Chiang, ThyssenKrupp Elevator, customers of applicant; (3) industry literature from

third parties discussing their elevator roller guides; (4) an agreement entered into with Bral Corporation, a supplier of applicant; (5) the declaration of Douglas W. Hamilton, III, applicant's vice-president; and (6) samples of applicant's advertising. [FN10]

FUNCTIONALITY UNDER SECTION 2(e)(5)

Under the statute, functional matter is unregistrable. 15 U.S.C. § 1052(e)(5). Matter is functional if "it is essential to the use or purpose of the article or if it affects the cost or quality of the article." TrafFix Devices Inc. v. Marketing Displays Inc., 532 U.S. 23, 58 USPQ2d 1001, 1006 (2001) (citation omitted). In making our determination of functionality we apply the test first set forth in In re Morton Norwich Products, Inc., 740 F.2d 1550, 213 USPQ 9 (CCPA 1982). See Valu Engineering Inc. v. Rexnord Corp., 278 F.3d 1268, 61 USPQ2d 1422, 1427 (Fed. Cir. 2002); American Flange & Manufacturing Co., Inc. v. Rieke Corporation, 80 USPQ2d 1397 (TTAB 2006). Morton-Norwich identifies the following factors to be considered in determining whether a particular design is functional: (1) the existence of a utility patent disclosing the utilitarian advantages of the design; (2) advertising materials in which the originator of the design touts the design's utilitarian advantages; (3) the availability to competitors of functionally equivalent designs; and (4) facts indicating that the design results in a comparatively simple or cheap method of manufacturing the product. Morton-Norwich, supra, 213 USPQ at 15-16.

***4** With regard to the first factor, the existence of a utility patent "is strong evidence that the features claimed therein are functional" and "[w]here the expired patent claimed the features in question, one who seeks to establish trade dress protection must carry the heavy burden of showing that the feature is not functional, for instance by showing that it is merely an ornamental, incidental, or arbitrary aspect of the device." TrafFix, supra, 58 USPQ2d at 1005. Further, third-party utility patents may be relied upon as evidence; ownership of the utility patent is not relevant. American Flange, supra. See also In re Virshup, 42 USPQ2d 1402, 1405 (TTAB 1997).

The Federal Circuit has clarified the role of the third Morton-Norwich factor:

> Nothing in TrafFix suggests that consideration of alternative designs is not properly a part of the overall mix, and we do not read the Court's observations in TrafFix as rendering the availability of alternative designs irrelevant. Rather, we conclude that the Court merely noted that once a product feature is found functional based on other considerations, there is no need to consider the availability of alternative designs because the feature cannot be given trade dress protection merely because there are alternative designs available. But that does not mean that the availability of alternative designs cannot be a legitimate source of evidence to determine whether a feature is functional in the first place. Valu Engineering Inc. v. Rexnord Corp., supra, 61 USPQ2d at 1428 (footnote omitted). [FN11]

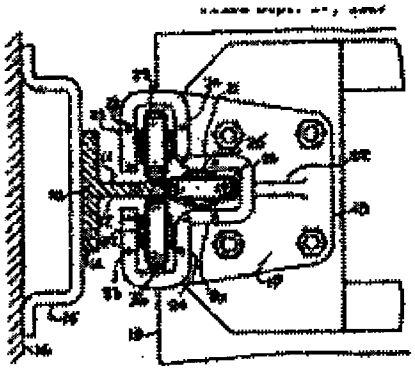
Utility Patents

We turn first to a consideration of the various utility patents of record. The examining attorney makes the following observations:

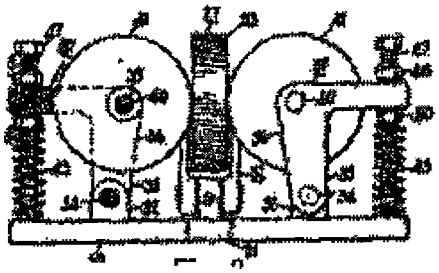
> Having examined prior patents issued to third parties for elevator roller guides made of record by the applicant, and having considered the development of the arts as applied to such devices, the Trademark Examining Attorney found no part of the configuration of the goods in question that appears to be without a functional purpose. The three wheeled roller guide is described in U.S. Patent 1,713,165 (1929). The pivotal supports for each roller and spring tension on the wheels are claimed in U.S. Patent 1,854,976 (1932), albeit in a different

configuration, however, the utilitarian purpose is the same. The six wheel guide is described in U.S. Patent 3,329,240 (1967) and also in U.S. Patent 3,856,117 (1967), which has a highly similar configuration of wheels, pivot arms, and bolt and spring assemblies. The Trademark Examining Attorney notes that similar U.S. Patents 2,251,963 (1941) and 2,253,820 (1941) (for five and six wheeled roller guides) and 2,265,086 (1941) (for pressure adjusting features on elevator roller guides) may have belonged to predecessors in interest of the applicant. A supporting base structure of some sort appears to be part of all of the patents for elevator roller guides. That the component parts of roller guides may be produced in other shapes or forms that all perform the same function does not detract from the utility provided by any of the alternative forms. Granting the applicant the exclusive use of an elevator roller guide with three or six wheels supported by pivotal arms with spring and bolt assemblies for the application of pressure to the wheels designed for a standard 'T' rail would severely hamper the ability of other elevator part manufacturers to provide suitable rail stability devices for use with elevators traveling on similar rails and for use with similar speeds and weight allowances. That these features were the subject of claims in prior patents clearly establishes the utilitarian nature of the features, and shows that other manufacturers of the goods have a right to those features that have now passed into the public domain by virtue of the expiration of the patents.
***5** Br. unnumbered pp. 5-6.

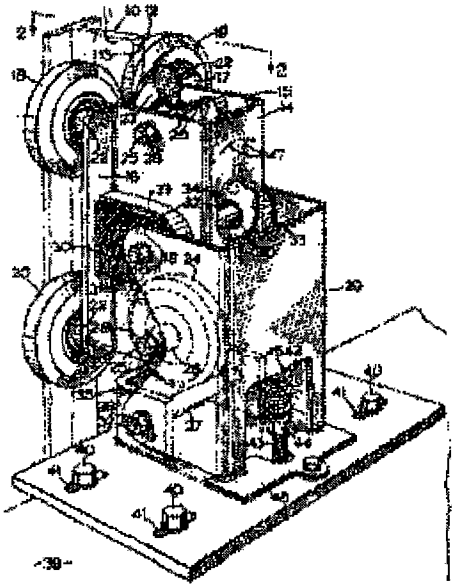
Drawings from the various patents noted by the examining attorney are shown below.



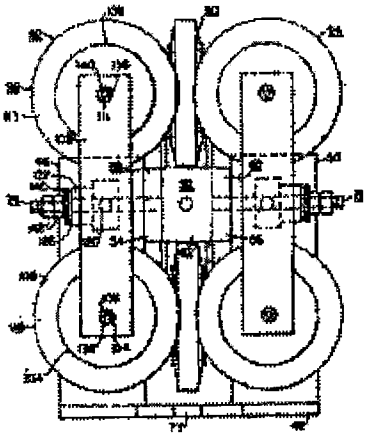
Patent No. 1713165 (three-wheeled roller guide)



Patent No. 1854976 (pivotal supports for roller and springs)



Patent No. 3329240 (six-wheeled guide)



Patent No. 3856117 (six-wheeled guide)

The three patents that were assigned to applicant's predecessor-in-interest are shown below.

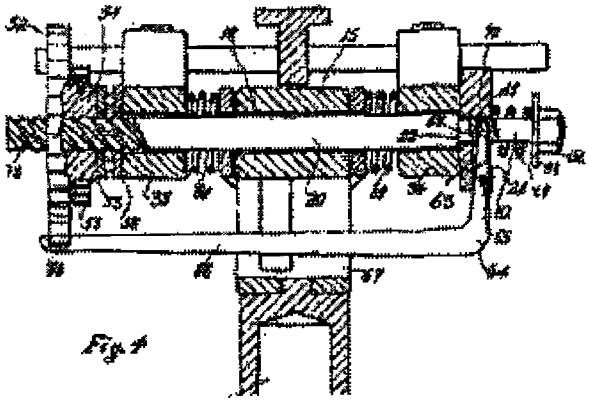
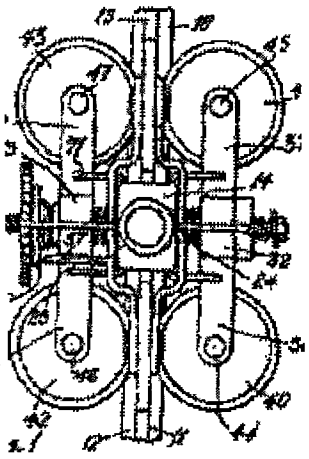


Fig. 4



Patent No. 2265086

(pressure adjusting feature)

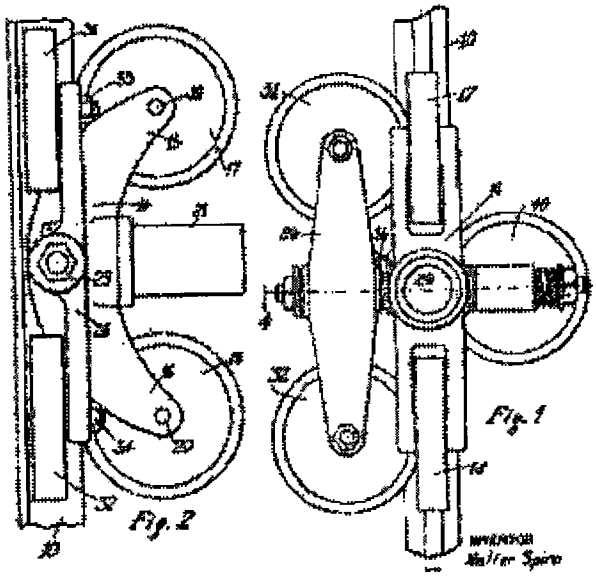
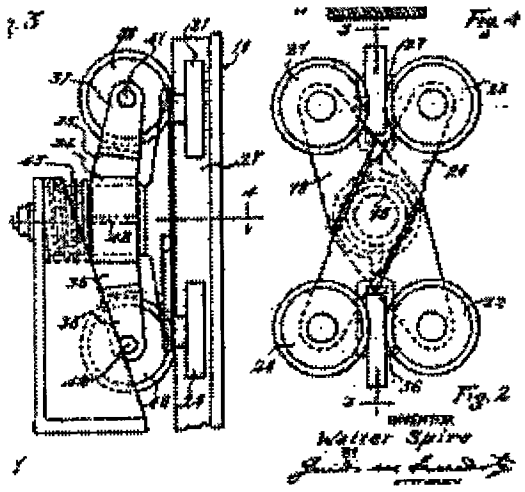


Fig. 2

Fig. 1

Patent No. 2251963



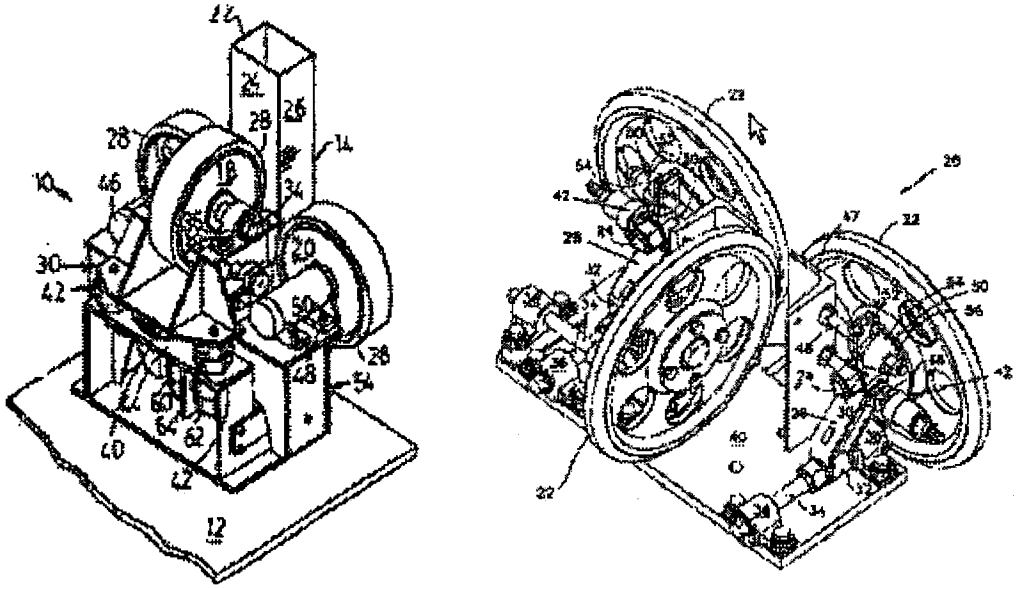
Patent No. 2253820

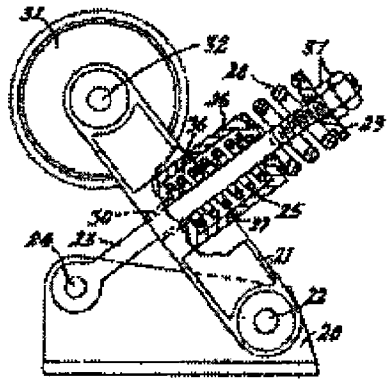
Patent No. 2251963, issued on August 12, 1941, is for a "roller guide for elevator cars." The patent drawings illustrate the various key features, including, diamond-shaped pivot arms, U-configured pivot arms, spring-bolt assemblies going through the pivot arms, and a parallel construction to ride on the rail. But for the absence of the oval hole in the side pivot arm, these features are virtually identical to the diamond-shaped pivot arms, the U-configured pivot arms and the spring-bolt assemblies claimed in applications Serial Nos. 76507505, 76507507, 76507675, and 76507734. The patent discloses that it is designed to be an improvement of prior art that "may be constructed in a much simpler form, calculated to further reduce the friction in operation, while calling for a much lighter structure, adapted to be produced at considerably less cost." The design is "automatically adjustable to unbalanced loading of the elevator and to rails presenting bends and other irregularities, while preventing undue friction and noisy operation of the elevator." Further, "the guide structure comprises an elongated frame formed at each end with a bifurcated, outwardly extending support ... the frame extends in front of, and parallel with the rail and the wheels or rollers are of equal diameter, and are symmetrically mounted with respect to the center of the frame...[t]he construction described thus provides a three-point rolling contact for the guide, which is possessed of a great amount of flexibility in action, inasmuch as the resilient mounting of both the yoke and sleeve make it possible for all the rolling elements to instantly adjust themselves to such bends, misalignments and inequalities as may occur at certain points in the guide rail...[t]he treads with which the wheels or rollers are equipped, being to a certain extent compressed when forced against the running surfaces of the guide rail by the action of springs as well as by the spring housed within the hub also serve to provide a certain amount of resilient action, insuring continuity of contact between said wheels and said rail even when some particularly sharp irregularity occurs in the guide rail...[t]he constructional details of my invention may vary from those shown without departing from the inventive idea. The drawing should, therefore, be understood as being intended for illustrative purposes only and not in a limiting sense." The patent claims, inter alia, "In an elevator guide for use in connection with a guide rail having an end riding surface and two side riding surfaces the combination, with a frame, of a yoke oscillatable in a plane substantially parallel to said end riding surface, mounted at one side of said frame, a roller at each end of said yoke adapted to ride along one of said side riding surfaces, resilient means urging said yoke and rollers against said side surface, a roller carried by the other side of said frame at a point

intermediate said two rollers, adapted to ride along the other side riding surface of said rail, and resilient means urging said roller against said second mentioned side riding surface."

***6** The role of the springs is further articulated in Patent No. 2253820 shown above. The elevator roller in this patent is designed so that "a single spring may be used to press the side guiding elements into contact relationship between the rollers and the guide-rail; furthermore, it will be seen that any deviation of the elevator car from its normal path in a direction transversal to the rib portion of the guide-rail, causing one or the other of the side surfaces of the rail to react against the rollers riding along the same, will result in an immediate increase in the torsion of the spring, which will thus be more effective in returning conditions to normal. Furthermore, if an abnormal condition arises due to an irregularity in the rail, causing a reaction to take place by the rail against only one of the rollers, the tension of the spring will in this case also be increased, causing the roller directly opposite to press with increased pressure against its own riding surface, thus giving rise to a counter reaction, which will be paired with the action of the arm which was previously deflected from its normal position, in returning conditions to normal. In both cases, therefore, the tension of the spring is increased under abnormal stresses, causing swinging movement of one or both arms around their common axis, and furthermore, the force exerted by the spring is utilized in its entirety in reestablishing normal conditions." This patent claims, inter alia, "each arm having a roller at each end, a helical spring, interposed between said arms, urging said arms to rotate each in the direction in which one of its rollers will press against one of said side riding surfaces, and the other roller will press against the opposite surface, a frame mounted on, and shiftable along said bearing, having two longitudinally spaced rollers adapted to ride along said end riding surface, and a spring urging said frame towards said end riding surface."

We further note Patent Nos. 5107963 and 6062347 showing three-wheeled elevator roller guides in alignments similar to applicant's proposed marks in application Serial Nos. 76507677, 76507735, 76507737, and 76507741 and an angled pivot arm with spring-bolt assembly similar to those depicted in Serial Nos. 76507677, 76507735, 76507737, and 76507741.





Applicant argues that "the design for which [applicant] is seeking federal registration has not been the subject of a utility or design patent or patent application." Br. p. 10. That applicant has chosen to pursue trademark protection rather than patent protection, does not render an otherwise functional configuration non-functional. As can be seen from the several utility patents made of record, each piece of applicant's elevator roller guides has a functional purpose: the diamond-shaped pivot arm, a standard yoke shape; the U-configured pivot arm to sit between the side pivot arms and allow room for the wheel to clear the arm and make contact with the face of the rail; the springs to present counter pressure; and the bolts to hold everything in place. It also appears that applicant's three-wheeled designs may have further utility in that the angled arms may be adjusted as noted in its advertising material discussed below.

***7** Accordingly, we conclude that the patent evidence supports a finding that applicant's proposed marks are functional.

Advertising

Under this factor, we consider evidence regarding "advertising materials in which the originator of the design touts the design's utilitarian advantages." The examining attorney highlights the following from applicant's literature that discusses the attributes of the proposed marks in application Serial Nos. 76507675 and 76507734: [FN12]

ELSCO's Model A Guides set the performance standard against which all other guides are measured. When seeking optimum performance on either high speed passenger or heavy duty freight elevators, quality conscious elevator contractors through-out the world turn to the design advantages of the tandem-wheel Model A.

The "walking beam action" of the side and face wheel arms compensates for unbalanced cars or misaligned rail conditions. Fully adjustable stabilizing springs allow the elevator car to float between the rails, eliminating the bumps and vibrations that affect ride quality.

Postwise float can be precisely controlled with adjustable stops, a standard feature on the Model A Guide.

We further note the following excerpts from applicant's advertising literature: [FN13]

ELSCO's 35 years of advanced engineering and manufacturing technique have led to the development of roller guides and guide shoes to meet almost all elevator load, speed or dimensional requirements. For high speed passenger or heavy duty freight elevators. Our six-wheel Model A and C Guides set the standard for optimum performance. With six wheels, the load carrying capability of the guide is increased, and the shock of a bump is spread over a larger area.

The Model B and D Guides are three-wheel counterparts to the Model A and C Guides, and are recommended for applications where speed and capacity are moderate.

ELSCO's Model E Guide offers a simpler design, yet provides optimum performance and cost effective operation on low rise, light to moderate capacity hydraulic elevators.

ELSCO Model B elevator roller guides are designed with adjustment features that provide superior riding characteristics. The installer can easily adjust ELSCO guides to compensate for adverse operating conditions and to minimize noise, bumps and vibration.

...

our spring-loaded roller guides have the ability to compensate for unbalanced cars or misaligned rail conditions.

...

A spring located in the hub of the wheel cluster assembly plays an integral role in the performance of these high speed roller guides. In addition to helping the roller wheels maintain constant contact with the rail, the spring action helps the car float along the rail in a controlled manner. The spring absorbs most of the shock and bumps caused by rail irregularities, isolating noise and vibration from the car.

...

This 'knee action' takes place on three sides of the rail, keeping the wheels in constant contact with the rails. These guides are also designed with a low profile for tight vertical clearances.

***8** ...

ELSCO Model C elevator roller guides are designed with adjustment features that provide superior riding characteristics. The installer can easily adjust ELSCO guides to compensate for adverse operating conditions and to minimize noise, bumps and vibration.

...

Each wheel arm assembly is individually spring mounted, allowing the guide to provide the smoothest possible ride, even when rails are rough or slightly misaligned. The wheel arm "knee action" keeps all wheels in constant contact with the rail.

These statements clearly tout the utilitarian advantages of the various features previously discussed in the patents. For example, the side and face wheel arms compensate for unbalanced cars, six wheels increases the load-carrying capacity of the guides, the spring-loaded roller guides compensate for unbalanced cars, and the spring in the hub of the wheel cluster absorbs shocks and bumps and helps the rollers maintain constant contact with the rail.

Accordingly, we conclude that the advertising evidence supports a finding that applicant's marks are functional.

Applicant argues that the examining attorney has failed to meet her burden to present a prima facie case of functionality because she has merely dissected the mark and pointed to certain features that may be functional but has not presented a case that the overall configuration is functional. Applicant further contends that the evidence of record does not support a functionality refusal because it is directed only to certain particular features. Applicant particularly notes that its literature does not tout the utilitarian advantages of its overall resulting configuration.

The statute prohibits registration of a mark that "comprises any matter that, as a whole, is functional." 15 U.S.C. 1052(e)(5). The issue then is how do we determine the functionality of the whole. The PTO has the burden of showing that a configuration is functional and it may accomplish that task by showing the functionality of various aspects of the configuration. See e.g., In re R.M. Smith, Inc., 734 F.2d 1482, 222 USPQ2d 1, 2 (Fed. Cir. 1984) ("[the board] proceeded to

initially review the six features claimed by Smith to comprise its mark. Upon consideration of the entire design, the board found that not only were those features themselves highly functional, except perhaps for the ribs, but that the drawing as a whole included various other highly functional elements, i.e.[b]ased on the functionality of the individual features comprising the design, the board concluded that the design as a whole was de jure functional. We agree with the board that the PTO attorney established a prima facie case of de jure functionality.")

Applicant relies on In re Teledyne Industries Inc., 696 F.2d 968, 217 USPQ2d 9 (Fed. Cir. 1982) (dissecting proposed product design into its utilitarian features not conclusive that design considered as a whole is functional) in support of its position. However, even in Teledyne the Federal Circuit recognized that "in most cases ... the best the PTO can probably do is to analyze a design from the standpoint of its de facto functional features, perhaps with support from technical articles, patent disclosures, or the applicant's own advertisements." Teledyne, supra, 217 USPQ at 11.

***9** The fact that a utility patent does not exist for each of the same exact overall configurations as applicant's designs is not sufficient to rebut the evidence of record establishing functionality. The configurations are by their nature functional because the designs bring the functional features together and the configurations retain the functional aspects of their parts. They are, in the end, only the sum of their parts, inasmuch as the various patents of record show the way in which the parts are put together and interact.

Even if we were to agree with applicant's argument that the configurations include non-functional features, for example the oval-shaped holes, the clearly functional features included in applicant's descriptions of the marks, as described above, are part of the overall configurations that applicant seeks to register. As stated by the Federal Circuit, "The case law of this court and its predecessor also establishes that before an overall product configuration can be recognized as a trademark, the entire design must be arbitrary or non de jure functional." Petersen Mfg. Co. v. Central Purchasing Inc., 740 F.2d 1541, 1550, 222 USPQ 562, 569 (Fed. Cir. 1984). See also In re Minnesota Mining and Mfg. Co., 335 F.2d 836, 142 USPQ 336 (CCPA 1964).

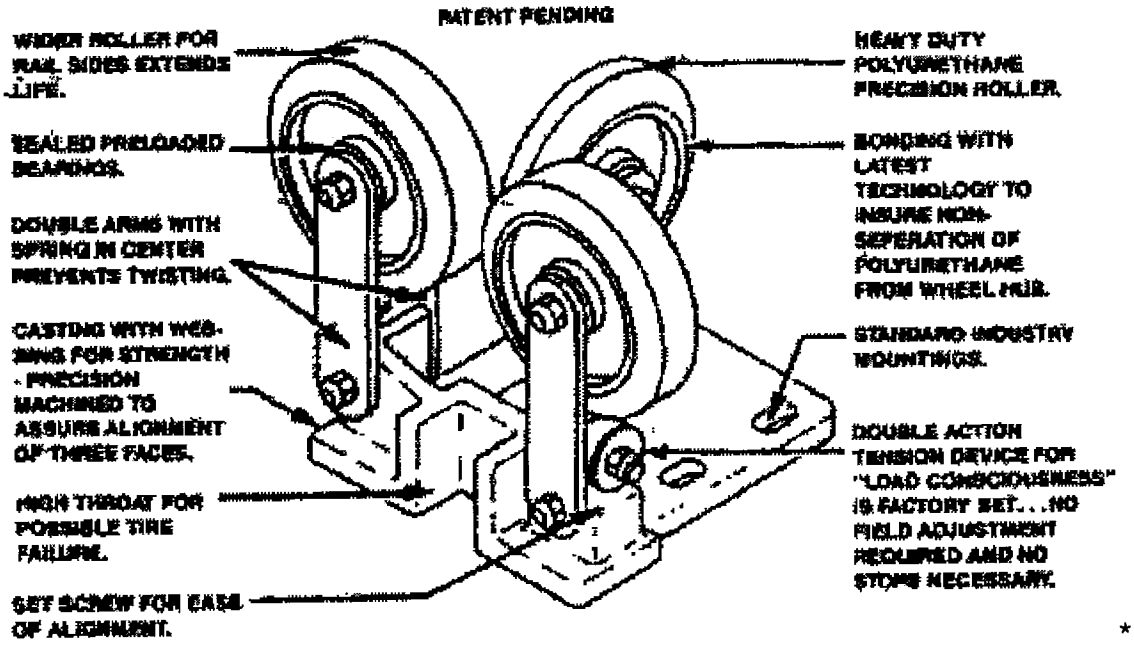
Alternative Designs/Cost of Manufacturing

It is applicant's position that the evidence, including the third-party patents and product catalogs, far from supporting a functionality refusal, in fact, preclude a finding of functionality because they show that alternative designs exist, and that, based on the declarations, the record supports a finding that its designs do not result "in a comparatively simple or cheap method of manufacturing the products." Br. p. 12. Once again applicant relies on Teledyne to support its position.

In Teledyne the Federal Circuit noted that the applicant had not shown that commercially feasible alternatives existed and thus had not rebutted the examining attorney's prima facie case. Applicant here argues that evidence of such alternatives exist in this case. However, since Teledyne, the United States Supreme Court in TrafFix has addressed the relevance of commercial alternatives as noted above. The Federal Circuit in Valu Engineering clearly stated that "once a product feature is found functional based on other considerations ... the feature cannot be given trade dress protection merely because there are alternative designs available." Valu Engineering, supra, 61 USPQ2d at 1427. Thus, the fact that other competitive alternatives may exist, does not alter the initial finding that the

configuration is functional and, thus, unregistrable.

In addition, we note that some of the alternative designs are very similar to applicant's designs. An example from the Hollister-Whitney Elevator Corporation is depicted below with a "patent pending" statement.



*10 The primary difference between this design and applicant's three-wheeled design is the angle at which the arms are placed. As noted in applicant's literature, its arms have the added utility of being adjustable.

Finally, while applicant has provided examples of alternative elevator roller guides and the declarations of Mr. Ferguson and Mr. Chiang attesting to the fact that each of applicant's guides "is one of many feasible, efficient and competitive designs," it has not explained how its designs are not superior to these other designs. It may be that applicant's configurations perform better than the alternative designs, but at more expense, so while the other designs may compete on price they do not compete on performance.

With regard to the cost of manufacturing, the examining attorney noted that:

> The relative costs of competing goods has not been addressed by any party except for the statement from one party, Mr. Hamilton, the applicant's Vice President, who states that he is "not aware of any fact that in any way suggests that the design of the Model A roller guide results from a simple or inexpensive method of manufacture as compared to alternative designs." Similar statements are made for the various models. Nonetheless, no actual evidence has been made of record showing comparable roller guides and the relative costs of manufacture...The applicant does not address whether the various designs or expenses of the applicant's goods is comparable to that of others. Rather, the applicant is "not aware that its goods result from a simple or inexpensive method of manufacturing as compared to alternative designs." In any event, the Court in TrafFix held that "where the design is functional under the Inwood formulation there is no need to proceed further to consider competitive necessity."

Br. unnumbered pp. 11-12 (citations omitted).

Applicant argues that the examining attorney has conceded that she has no basis for making an assertion that [applicant's] configurations affect the cost of the article. Br. p. 6. However, the information regarding the comparative costs of manufacturing for different designs resides with the applicant and applicant did not provide more than the one statement from its vice president that he is not aware that its goods result from a simple or inexpensive method of manufacturing. Moreover, even if its elevator guides are not "comparatively simple or cheap" to manufacture, this does not mean that the design is not functional. In re American National Can Co., 41 USPQ2d 1841, 1844 (TTAB 1997).

Accordingly, we conclude that the evidence of alternative designs and cost of manufacturing does not support a finding of non-functionality.

Because all or substantially all of applicant's overall designs are dictated by the function they perform, we affirm the refusals based on functionality. See In re Vico Products Mfg. Co., 229 USPQ 364, 368 (TTAB 1985).

***11** Once a configuration is found to be functional, a showing of acquired distinctiveness cannot transform it into a trademark. However, for completeness we address the failure to function refusal and applicant's evidence submitted in support of its claim of acquired distinctiveness below.

FAILURE TO FUNCTION UNDER SECTIONS 1, 2 AND 45

In response to the refusals based on lack of inherent distinctiveness applicant argues that its marks have acquired distinctiveness. In support of its assertion of acquired distinctiveness, applicant relies on: (1) the declaration of Douglas W. Hamilton, III; (2) the declaration of Gordon Fergusen; (3) the declaration of Wayne Chiang; (3) the Bral Corporation agreement; and (4) applicant's advertising.

Product design, as a matter of law, is not inherently distinctive and can only be registered upon a showing of acquired distinctiveness. Wal-Mart Stores, Inc. v. Samara Brothers, Inc., 529 U.S. 205, 54 USPQ2d 1065, 1068 (2000); In re Ennco Display Systems, Inc., 56 USPQ2d 1279 TTAB (2000). Refusals based on failure to function may be overcome by a showing of acquired distinctiveness under Section 2(f) of the Trademark Act. The burden of proving a prima facie case of acquired distinctiveness in an ex parte proceeding rests with applicant. Yamaha Int'l Corp. v. Hoshino Gakki Co. Ltd., 840 F.2d 1572, 6 USPQ2d 1001, 1004 (Fed. Cir. 1988). An applicant must show that the primary significance of the product configuration in the minds of consumers is not the product but the source of that product in order to establish acquired distinctiveness. See In re Steelbuilding.com, 415 F.3d 1293, 1297, 75 USPQ2d 1420, 1422 (Fed. Cir. 2005); In re Ennco Display Systems Inc., supra. Acquired distinctiveness may be shown by direct and/or circumstantial evidence. Direct evidence includes actual testimony, declarations or surveys of consumers as to their state of mind. Circumstantial evidence is evidence from which consumer association might be inferred, such as years of use, extensive amount of sales and advertising, and any similar evidence showing wide exposure of the mark to consumers. In re Ennco, 56 USPQ2d at 1283. See also 2 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, Sections 15:30, 15:61, 15:66 and 15:70 (4th ed. 2005).

There is no fixed rule for the amount of proof necessary to demonstrate acquired distinctiveness, however, the burden is heavier for configurations. In re Ennco, 56 USPQ2d at 1283 (product configurations face a heavy burden to establish secondary meaning). See also Yamaha, supra, 6 USPQ2d at 1008 (evidence required to show acquired distinctiveness is directly proportional to the degree of non-distinctiveness of the mark at issue).

***12** After careful review of the evidence of record, we agree with the examining attorney that applicant's evidence of acquired distinctiveness is insufficient to permit registration of the configurations under Section 2(f).

Applicant claims to have sold between 22,000 and 60,000 units of each of its elevator rollers since 1998 and spent approximately $100,000 on advertising via the catalogs and brochures. Hamilton Decl. ¶ 5.

While the sales volume figures may demonstrate the growing popularity of the product, mere figures demonstrating successful product sales are not probative of purchaser recognition of a configuration as an indication of source. See Braun Inc. v. Dynamics Corp., 975 F.2d 815, 827, 24 USPQ2d 1121, 1133 (Fed. Cir. 1992) ("[L]arge consumer demand for Braun's blender does not permit a finding the public necessarily associated the blender design with Braun."); In re Bongrain Int'l (American) Corp., 894 F.2d 1316, 1318, 13 USPQ2d 1727, 1729 (Fed. Cir. 1990) (growth in sales may be indicative of popularity of product itself rather than recognition as denoting origin). Moreover, it is well established that compelling sales and advertising figures do not always amount to a finding of acquired distinctiveness. See In re Boston Beer Co. L.P., 198 F.3d 1370, 53 USPQ2d 1056 (Fed. Cir. 1999) ($85,000,000 in annual sales revenues and $2,000,000 in advertising expenditures found insufficient to establish acquired distinctiveness); Goodyear Tire & Rubber Co. v. Interco Tire Corp., 49 USPQ2d 1705 (TTAB 1998) ($56,000,000 sales revenues and 740,000 tires sold insufficient to show acquired distinctiveness of tire tread design).

Although there may have been substantial sales and some expenditures on advertising, the more important question is how is the alleged mark being used, i.e., in what manner have consumers been exposed to the alleged mark so that we can impute consumer association between the configurations and the product producer. To determine whether a configuration has acquired distinctiveness, advertisements must show promotion of the configuration as a trademark.

Here, there is nothing of record that shows that the alleged marks are being promoted as source indicators. The examples in the record simply show a picture of the product. Applicant's contention appears to be that because pictures of the products appear near applicant's trade name or trademark ELSCO they serve as source-identifying marks. As the examining attorney stated:

> The photo is not promoted in a source identifying manner, but is merely used in the promotion of the goods in the context of providing information about the goods identified in the accompanying picture for the applicant's various models of elevator roller guides

***13** Br. unnumbered p. 14.

We see nothing in the record to show that the advertising promotes the configurations in a way that would imbue them with source-identifying significance; rather, the advertising simply shows the product like any advertising would. Applicant has not presented evidence of advertising or promotional efforts that focus upon the trademark significance of the configurations claimed as marks.

Applicant also submitted an agreement between it and one of its suppliers that includes the following statements:

> 4. Bral hereby expressly acknowledges that Hamilton and/or a related company is the owner of certain trademarks including but not limited to the marks consisting of (1) the red and black colors for roller guides and roller guide parts; and, (2) the product configurations for ELSCO's roller guides including but not limited to the product configurations of Model A, Model B, Model C and Model D roller guides.

5. Bral further agrees not to infringe upon any of Hamilton's or any related company's trademarks including but not limited to those identified in paragraph 4.

6. Bral hereby agrees not to contest the validity of Hamilton's or any related company's trademarks including but not limited to those identified in paragraph 4 in any proceeding including but not limited to any proceeding brought by Hamilton or any related company for enforcement of its trademarks.

Bral Agreement.

As noted by the examining attorney:

The statement does not state that it does or does not believe the configurations to identify the source of ELSCO's goods, but is merely recognition of ELSCO's claims of ownership for the product configurations, and further agrees not to infringe on any of the referenced marks.

Br. p. 15.

Finally, applicant submitted two consumer declarations which include the following statements:

The configuration of ELSCO'S Models A, B, C and D roller guides with and without wheels also identify ELSCO as the source of the roller guide. The configuration of each ELSCO's Models A, B, C and D roller guides is one of many feasible, efficient and competitive designs.

Chiang and Ferguson Decls.

We do not find these two identical declarations to be particularly persuasive. This conclusory statement is made without particularity as to how consumers are exposed to the alleged marks. In addition, the record does not reveal the extent of applicant's potential customer base and whether these two declarations are sufficiently representative of most potential purchasers.

Accordingly, based upon consideration of all the evidence in the record, we find that applicant has failed to establish that the configurations involved in the applications before us have acquired distinctiveness within the meaning of Section 2(f).

Decision: The refusals to register the configurations claimed as marks in each application on the grounds that the configurations are functional, or not inherently distinctive and have not been shown to have acquired distinctiveness are affirmed.

FN1. On January 24, 2006, upon request by the examining attorney, the Board consolidated these eight appeals and the Board is addressing them in a single opinion. Citations to the briefs refer to the briefs filed in application Serial No. 76507505, unless otherwise noted; however, we have, of course considered all arguments and evidence filed in each case. Applicant also appealed the refusal issued in a related application, Serial No. 76507676. While the Board heard oral argument on that appeal as well as these consolidated appeals at the same oral hearing, the issues in application Serial No. 76507676 are different and a decision in that case is being issued under a separate opinion.

FN2. Application Serial No. 76507505, filed April 18, 2003, alleging January 1, 1980 as the date of first use and the date of first use in commerce.

FN3. Application Serial No. 76507507, filed April 18, 2003, alleging December 31, 1961 as the date of first use and first use in commerce.

FN4. Application Serial No. 76507675, filed April 18, 2003, alleging January 1, 1980 as the date of first use and first use in commerce.

FN5. Application Serial No. 76507734, filed April 18, 2003, alleging December 31, 1961 as the date of first use and first use in commerce.

FN6. Application Serial No. 76507735, filed April 18, 2003, alleging January 1, 1980 as the date of first use and first use in commerce.

FN7. Application Serial No. 76507737, filed on April 18, 2003, alleging December 31, 1961 as the date of first use and first use in commerce.

FN8. Application Serial No. 76507677, filed April 18, 2003, alleging January 1, 1980 as the date of first use and first use in commerce.

FN9. Application Serial No. 76507741, filed April 18, 2003, alleging December 31, 1961 as the date of first use and first use in commerce.

FN10. Applicant's objection to the examining attorney's arguments in her brief regarding certain features of applicant's proposed marks is not well taken. The examining attorney did not submit new evidence, refer to extrinsic evidence or raise a new refusal; she simply responded to applicant's argument raised for the first time in its brief that she had not ascribed any function or utility to certain aspects of applicant's mark.

FN11. In TrafFix the Supreme Court stated:

> It is proper to inquire into a 'significant non-reputation-related disadvantage' in cases of aesthetic functionality, the question involved in Qualitex. Where the design is functional under the Inwood formulation there is no need to proceed further to consider if there is a competitive necessity for the feature. In Qualitex, by contrast, aesthetic functionality was the central question, there having been no indication that the green-gold color of the laundry press pad had any bearing on the use or purpose of the product or its cost or quality.

TrafFix, supra, 58 USPQ2d at 1006.

FN12. ELSCO is apparently another name for applicant.

FN13. Similar excerpts are in the record for each model applicant seeks to register as a trademark.

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